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No.

In the Supreme Court of the United States

LOGITECH INC.,

Petitioner,

v.

SAMUEL GART,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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November 19, 2001

QUESTIONS PRESENTED

The present case involves a patent directed to the shape of a handheld computer controller, such as a computer mouse. Like all patents, the patent at issue includes a specification describing the invention and claims setting the metes and bounds of the patent rights. The statutory purpose of the specification and claims is to put the public on "notice" as to what constitutes the invention and infringement and what does not.

This case presents the important question of whether statements made in a patent specification as filed to distinguish an invention over pre-existing technology ("prior art") are as important as similar statements made *after* filing and during the examination process for the patent. This question has direct bearing on two issues: (1) claim interpretation; and (2) application of the doctrine of equivalents.

The questions presented are:

(1) Whether statements distinguishing prior art made in the specification as filed should be accorded the same effect as statements made later, during the prosecution, for purposes of claim construction.

(2) Whether statements distinguishing prior art made in the specification as filed should be accorded the same effect as statements made later, during the prosecution, for purposes of the doctrine of equivalents.

PARTIES TO THE PROCEEDING

The parties to the proceeding in the United States Court of Appeals for the Federal Circuit are the same as the parties to this proceeding: Petitioner Logitech Inc.[1] and Respondent Samuel Gart.

[1] Pursuant to Supreme Court Rule 29.6, Petitioner states that its corporate parent is Logitech International S.A. Respondent has no subsidiaries or affiliates that have issued shares to the public.

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No. _____

In the Supreme Court of the United States

OCTOBER TERM, 2001

LOGITECH INC.

Petitioner,

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SAMUEL GART

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On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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PETITION FOR WRIT OF CERTIORARI

Logitech Inc. ("Logitech") hereby petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The Federal Circuit panel opinion affirming-in-part, vacating-in-part, reversing-in-part and remanding for determination of infringement based on the new claim construction is reported in *Gart v. Logitech Inc.*, 254 F.3d 1334 (Fed. Cir. 2001), and reprinted in the Appendix at App.

1-23. The Federal Circuit decision entering judgment denying rehearing and rehearing *en banc* is reported at 2001 U.S. App. LEXIS 21100 (Fed. Cir. Aug. 21, 2001) and reprinted at App. 42. The district court decisions granting summary judgment of non-infringement literally and under the doctrine of equivalents are unreported but are included at App. 24-34 and App. 35-41, respectively.

JURISDICTION

The Federal Circuit entered its opinion on June 26, 2001, and Logitech timely filed its combined petition for rehearing and rehearing *en banc* on July 10, 2001. On August 21, 2001, the Federal Circuit denied Logitech's petition. This Court has jurisdiction under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article 1, section 8, clause 8 of the Constitution provides:

> Congress shall have the power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their Respective Writings and Discoveries.

35 U.S.C. § 112, ¶¶ 1 and 2, provide that:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and

> shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. § 271(a) provides that:

> Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

STATEMENT OF THE CASE

I. Prosecution History of the Gart Patent

On February 12, 1988, Samuel Gart ("Gart") applied for a patent on a simple invention – an ergonomic housing for a handheld computer controller, such as a mouse. Recognizing that others had invented similar structures, Gart differentiated his invention from the pre-existing structures discussed in the specification. As the first step in prosecuting his patent application, Gart filed his patent specification as required by Patent and Trademark Office ("PTO") regulations. Along with the application, Gart filed an Information Disclosure Statement ("IDS") advising the PTO of the prior art[2] known to him at that time.[3] In the IDS,

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[2] In the context used here, "prior art" refers to earlier issued patents and printed publications that are material to the examination of the application.

Gart listed, but did not comment on, five references. Gart used the specification to distinguish four of the five cited references from his invention. In other words, rather than discussing the cited references in the IDS, Gart relied on statements in his patent specification to distinguish his invention from the prior art references.

First, Gart generally summarized his statements for distinguishing the prior art as a whole, stating ". . . all such prior art known to the applicant either do not provide the full ergonomic surface design of the present invention or are simply incompatible with the surface shapes needed in a hand controller as opposed to other hand-related applications." (Lod. 5: U.S. Patent No. 4,862,165 ("the '165 patent"), col. 2:22-27). Gart then addressed each reference in turn. To distinguish U.S. Patent No. 4,550,250 ("the '250 patent"), Gart argued only that "the graphic input device does not have an undercut curved area for the middle, ring and small fingers, as provided in your [sic] system." (Lod. 5: the '165 patent, col. 2:44-46). Similarly, to distinguish U.S. Patent No. 3,517,678 ("the '678 patent"), Gart argued only, "no undercut area is provided for the user's middle, ring and small fingers." (Lod. 5: the '165 patent, col. 2:62-63).

Elsewhere in the specification, Gart described the "undercut" feature as a part of the medial ledge feature of the disclosed invention. He further emphasized that the undercut feature relied on to distinguish the invention from the prior art is this feature of his *invention*, and not any particular embodiment of it.

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[3] Under PTO regulations, 37 C.F.R. § 1.56, Gart, like all applicants for U.S. patents, was *required* to bring to the attention of the examiner any information known to him which might be material to the examination of his application.

> This particular feature of the invention permits advantageous comfortable positioning of the ring and small fingers during their relative inactivity while using the hand controller. *This feature in particular is one which the prior art controllers known to the applicant generally lack.*

(Lod. 7: the '165 patent, col. 5:38-43) (emphasis added).

Upon receiving the patent application and the IDS, the examiner sought authorization to amend claims 4, 5, and 7 so that the claims would comply with §112, ¶ 2. App. 42. Once the amendments were authorized, the examiner amended the claims accordingly and indicated that the application was in condition to issue as a patent. *Id.* The only reason stated by the examiner for approving the application was that "[t]he prior art fail[ed] to teach the details on the shape and surfaces of the hand controller taught by the instant claims." App. 14, 42. The *only* place where Gart provided any indication of the "details" which distinguished the prior art from the claimed invention was the specification.

The examiner also provided a list of eight references that were considered during the examination, including the four which were distinguished by Gart only in the specification as filed.

II. The Proceedings Below

A. The District Court Opinions

On July 23, 1998, Gart filed a complaint against Logitech alleging that several Logitech computer mice and

trackball products infringed the '165 patent. The U.S. District Court granted summary judgment in favor of Logitech, concluding that Logitech's accused products do not infringe claim 7 of the '165 patent, the only claim at issue, either literally or under the doctrine of equivalents. In construing the claim, the district court specifically relied on the specification where the inventor distinguished the prior art from his invention as well as technical and non-technical dictionaries. App. 29. As construed by the district court, claim 7 required a hand controller (*e.g.*, a mouse), which included an angular ledge for supporting the middle, ring and last fingers in an enclosed or folded position. *Id.* Because Logitech's accused devices lacked such an "angular medial surface," the district court found that the accused products did not infringe.[4]

B. The Federal Circuit Decision

The Federal Circuit panel reversed the district court's claim construction ruling on the basis that the district court had improperly allowed Gart's specification statements distinguishing prior art to limit the scope of the claim. App. 11-14.

In remanding the case to district court under this new claim construction, the panel further advised that Gart's statements made in the specification did not invoke prosecution history estoppel nor bar the application of the doctrine of equivalents. App. 17.

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[4] In addition, the district court held that four of the six accused products did not infringe the '165 patent because they did not have a support surface for the thumb or the thenar pad, both of which are elements of claim 7.

Logitech timely filed a petition for rehearing and rehearing *en banc*, which the Federal Circuit denied on August 21, 2001. App. 42.

On August 10, 2001, a different Federal Circuit panel issued an unpublished decision in *KX Industries, L.P. v. PUR Water Purification Products, Inc.*, No. 00-1543, 2001 U.S. App. LEXIS 18155 (Fed. Cir. Aug. 10, 2001) (reprinted at App. 45-57), in which the court essentially adopted the position urged by Logitech in its petition for rehearing, namely, that specification statements concerning prior art did in fact limit the scope of claims. *KX Industries* extended the ruling in *Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1304 (Fed. Cir. 1997) ([that "an argument contained in an IDS that purports to distinguish an invention from the prior art may affect the scope of the claims of a later granted patent"] to cover "a clear statement distinguishing the invention from the prior art that is in the *specification* itself") (emphasis added).

REASONS FOR GRANTING THE WRIT

This Court should hear this case because it presents an issue of exceptional importance to patent law: what can the public rely on as "notice" of what constitutes infringing acts. In this regard, the Federal Circuit has declined to resolve an intracircuit conflict between its panels regarding the effect of limiting statements made in the specification in the original patent application in contrast with those made during ensuing prosecution. The full Federal Circuit has declined to resolve this conflict, leaving this Court as the only arbiter of the issue.

Until the questions presented in this case are authoritatively answered, the scope and extent of patent rights throughout the nation will remain uncertain. Inventors

and manufacturers in our increasingly technology-driven economy will not know whether specification statements made in the patent application limit the scope of the patent right. While garden-variety intracircuit conflicts might not call for this Court's exercise of its certiorari jurisdiction, an intracircuit conflict in the Federal Circuit, on an issue involving first principles of patent law, is intolerable.

I. There Is an Intracircuit Conflict at the Federal Circuit Regarding Whether, for Claim Interpretation Purposes, a Disclaimer of Subject Matter in a Patent Specification Should Have the Same Effect as a Disclaimer of Subject Matter Which Occurs During Prosecution.

A surrender of subject matter occurs either when an applicant for a patent limits his patent claims or offers statements distinguishing his invention from the prior art. The *en banc* Federal Circuit has reasoned that there is no reason why an amendment-based surrender of subject matter should be given less force than a statement-based surrender of subject matter: "The logic of prosecution history estoppel is that the patentee, during prosecution, has created a record that fairly notifies the public that the patentee has surrendered the right to claim particular matter as within the reach of the patent." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 564-65 (Fed. Cir. 2000) (*en banc*), *cert. granted*, 121 S. Ct. 2519 (2001). In order to preserve this notice function, disclaimer of subject matter should apply equally to any statement made by the inventor which limits or disclaims the scope of an invention, regardless of whether the inventor made the statement in the specification as filed or at some later point during the prosecution of the patent application.

A. The Federal Circuit Panel Decision in *KX Industries* Directly Conflicts with the Panel Holding in the Instant Case and the Full Court Has Declined to Resolve this Conflict.

The Constitution empowers Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8. Congress first exercised this authority in 1790, when it provided for the issuance of "letters patent," Act of Apr. 10, 1790, ch. 7 § 1, 1 Stat. 109, which, like their modern counterparts, granted inventors "the right to exclude others from making, using, offering for sale, selling, or importing the patented invention," in exchange for full disclosure of an invention. *Markman v. Westview Instruments Inc.*, 517 U.S. 370, 373 (1995) (citing H. SCHWARTZ, PATENT LAW AND PRACTICE 1, 33 (2d ed. 1995)).

It has long been understood that a patent must describe the exact scope of an invention and its manufacturer to "secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them." *McClain v. Ortmayer*, 141 U.S. 419, 424 (1891). Under the modern American system, these objectives are served by two distinct elements of a patent document. First, the patent document contains a specification which must describe the invention "in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same." 35 U.S.C. § 112, ¶ 1. Second, a patent includes one or more "claims," which must "particularly poin[t] out and distinctly clai[m] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 ¶ 2. The claim "define[s] the scope of a patent grant." 3 E LIPSCOMB, WALKER ON PATENTS § 11:1, p. 280 (3d ed. 1985).

Characteristically, patent lawsuits charge infringement and rest on allegations that the defendant "without authority made, used or sold the patented invention, within the United States during the term of the patent therefor . . . ." 35 U.S.C. § 271(a). Victory in an infringement suit requires a finding that the patent claim "covers the alleged infringer's product or process," which in turn necessitates a determination of "what the words in the claim mean." *Markman*, 517 U.S. at 374 (citing SCHWARTZ, *supra*, at 80 and LIPSCOMB, *supra*, at 288-90).

In *Markman*, this Court answered in the affirmative the question of whether a determination of what the words of a claim mean, also known as claim construction or claim interpretation, is an issue of law to be decided by the Court. *Id.* at 391.

The issues in the present case go to how the so-called "intrinsic" claim interpretation tools – the "record" which the public has available to interpret patent claims, *Vitronics Corp. v. Conceptronic, Inc*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) – should be used. The Federal Circuit has held that a court should look first to the intrinsic evidence of record, *i.e.*, the claims, the specification, and the prosecution history. *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1331 (Fed. Cir. 2001) (citing *Vitronics*, 90 F.3d at 1582). In construing a particular claim element, the specification is usually dispositive and the "single best guide to the meaning of a disputed term." *Vitronics*, 90 F.3d at 1582.

The intrinsic evidence includes a hierarchy of analytical tools. *Digital Biometrics, Inc. v. Indentix, Inc.*, 149 F.3d 1335, 1344 (Fed. Cir. 1998). The actual words of the claim are the focus. *Id.* The second tool in the hierarchy is the written description, *i.e.*, the patent specification, followed by the third tool, the prosecution history. *Id.* The

focus of the present petition is on the patent specification, second only to the claims themselves as the primary analytical tool on which the public is entitled, indeed *instructed*, to rely in assessing the scope of the subject matter that the '165 patent reserves to Gart.

The Federal Circuit decision in *KX Industries* directly conflicts with the panel's decision in the present case. In short, an intracircuit conflict has arisen as to the role of the specification in connection with claim construction. By denying Logitech's petition for *en banc* rehearing, the Federal Circuit declined to resolve this intracircuit conflict.

The panel in *KX Industries* held:

> Where the *specification* makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claim, read without reference to the specification, might be considered broad enough to encompass the feature in question.

KX Industries, App. 52 (citing *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc*, 242 F.3d. 1337, 1341 (Fed. Cir. 2001) and *Cultor Corp. v. A.E. Staley Mfg. Co.*, 244 F.3d 1328, 1331 (Fed. Cir. 2000) ("Claims are not correctly construed to cover what was expressly disclaimed.")).

In *KX Industries*, the claimed invention related to a method of preparing composite materials for filtering water. In the "Background" section of the specification, the inventor distinguished the invention from two prior art references. Both the district court and the Federal Circuit

panel viewed the distinctions disclosed in the specification as disclaimers which limited the scope of the claim.

> . . . express statements or arguments of limitation made in an information disclosure statement ("IDS"), in discussion with the examiner, or in the *specification* of the patent itself are all relevant in determining whether the express terms of the claim must be limited to exclude disclaimed subject matter.

Id. at App. 52-53 (emphasis added).

In *Ekchian v. Home Depot, Inc.*, the Federal Circuit held "that statements made in an IDS can be the basis for a court to interpret the scope of the claims of a granted patent." 104 F.3d at 1304. In *KX Industries*, the Federal Circuit panel expressly extended the *Ekchian* holding to include distinctions over the prior art made in the specifications:

> . . . just as an argument contained in an IDS that purports to distinguish an invention from the prior art may affect the scope of the claims of a granted patent, so may a clear statement distinguishing the invention from the prior art that is in the *specification* itself.

KX Indus., App. 53 (citations omitted) (emphasis added) (citing *Pall Corp. v. PTI Techs., Inc.*, 259 F.3d 1383, 1392 (Fed. Cir. 2001)).

Thus, there now exists an intracircuit conflict at the Federal Circuit as to the treatment of limiting statements urged in a specification as filed, but not urged elsewhere during prosecution.

Like the patentee in *KX Industries*, Gart distinguished his invention from the prior art in the specification.

Specifically, Gart identified only one particular feature, the "undercut curved area for the middle, ring and small fingers" that differentiated his invention from prior art U.S. Patent Nos. 4,550,250 and 3,517,678. (Lod. 5: the '165 patent, col. 2:43-46):

> However, the graphic input device does not have an undercut curved area for the middle, ring and small fingers, as provided in [this] system.

Gart further cited this feature, in addition to other features, to distinguish his invention from another prior art reference (U.S. Patent No. 3,854,131). (Lod. 5: the '165 patent, col. 2:27-63). Although Gart filed an IDS, it was simply a naked listing on a patent office form of the four prior art patent references discussed by Gart only in the specification.[5]

Claim 7, the only claim asserted against Logitech, recites "an angular medial surface for supporting the three remaining ulnar fingers in a wrapped configuration with flexion of the distal, middle and proximal phalanges of said ulnar fingers." This is the only claim element which (1) addresses the positions of the middle, ring and small fingers; and (2) directly correlates the claimed element to the distinguishing feature that Gart urged over the prior art. According no disclaimer weight to such an attempt to distinguish over the prior art invites gamesmanship. Indeed,

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[5] Had Gart included in his IDS statements making the distinctions over the listed prior art urged in the specification, the rule enunciated by the Federal Circuit in *Ekchian* would clearly apply: "[S]tatements made in an [Information Disclosure Statement] can be the basis for a court to interpret the scope of the claims of a granted patent." 104 F.3d at 1304.

the Federal Circuit panel in *KX Industries* explicitly recognized this conflict:

> In this case, the inventor distinguished his invention from [a prior art reference] *as a kind of preemptive strike against a potential rejection.* It is not clear that the assertions made were necessary for allowance of the claims. However, whether the limiting assertions made were necessary for allowance of the claims is not dispositive as to whether a patentee has disclaimed certain subject matter.

KX Indus., App. 53 (emphasis added).

Gart's attempt to avoid the precise holding of *Ekchian* by using the specification to distinguish prior art listed on an IDS form (but not otherwise discussed) is *exactly* the type of gamesmanship later foreclosed by the Federal Circuit panel in *KX Industries*. Unfortunately, in view of the panel's holding in *Gart*, there now exists an intracircuit conflict on this important specification-as-public-notice issue because the panel in Gart allowed precisely the use of the specification that *KX Industries* foreclosed. Because the inventing community – and, to a significant extent, the U.S. economy – must be able to depend on a single, uniform resolution of this issue, and because the Federal Circuit has failed to provide such a resolution, this Court should step into the void and decide the issue.

B. The Panel's Decision in *Gart* Conflicts with Other Federal Circuit Decisions Involving the Effect of Statements Which Surrender Subject Matter.

The decision of the panel in *Gart* wrongly discounts Gart's disclaimer of subject matter simply because it occurred in the specification. The panel acknowledges Gart's specific statement of distinction over the prior art with a rhetorical shrug and then quickly turns to other, less specific distinctions urged by Gart over the acknowledged prior art. App. 12-13.

However, it is well settled that a patent applicant cannot rely on a general conclusory statement of inventive concept to distinguish an invention, especially to soften the edges of a specific pronouncement of how the claims distinguish over the prior art. *See In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). ("We interpret [applicant's attempt to distinguish their 'inventive concept'] as a veiled attempt to avoid the potential future effects of prosecution history estoppel. Such evasiveness we cannot condone, particularly when the public must rely on the written record to define the resulting property rights.") (citing *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33-34 (1997)). The public, in evaluating the appropriate scope of a patent, is entitled to rely on global comments "made without reference to a particular claim." *Digital Biometrics*, 149 F.3d at 1347 ("The public has a right to rely on such definitive statements made during prosecution."). Notice is an important function of the patent prosecution process. The statute itself reflects this point, *see* 35 U.S.C. § 112, ¶¶ 1 and

2,[6] which this Court recently confirmed, *see Warner-Jenkinson*, 520 U.S. at 33.

The panel in *Gart* noted that despite Gart's specific reliance on the concave undercut area to distinguish over the prior art, the examiner never stated that he relied on that as the patentable difference over the prior art. App. 14. To even state such an observation in the context of subject matter disclaimer indicates that the panel was steering far off course from the mainstream jurisprudence of the Federal Circuit and this Court. *Laitram Corp. v. Morehouse Indus, Inc.*, 143 F.3d 1456, 1462 (Fed. Cir. 1998) ("The fact that an examiner placed no reliance on an applicant's statement distinguishing prior art does not mean the statement is inconsequential for purposes of claim construction.").

Examiner reliance is not the point. Public notice is the point. *Hockerson-Halbertact, Inc. v. Avia Group Int'l, Ltd.*, 222 F.3d 951, 957 (Fed. Cir. 2000) ("The prosecution history constitutes a public record of the patentee's representations concerning the scope and meaning of the claims, and competitors are entitled to rely on those representations when ascertaining the degree of lawful conduct, such as designing around the claimed invention."); *see also Spectrum Int'l, Inc. v. Sterlite Corp.*, 164 F.3d 1372, 1378 (Fed. Cir. 1998) ("That explicit argument made during prosecution can lead to narrow claim interpretations makes sense, because '[t]he public has a right to rely on such

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[6] The "notice provision" of the U.S. Patent Laws, 35 U.S.C. § 112, ¶¶ 1 and 2, requires that the claims, which must be read in view of and supported by the specification, particularly point out and distinctly claim the invention to provide to the public regarding the scope of the patent grant. *K-2 Corp. v. Salomon, S.A.*, 191 F.3d 1356, 1336 (Fed. Cir. 1999).

definitive statements made during prosecution.'") (citing *Digital Biometrics*, 149 F.3d at 1347).

The *Gart* panel glosses over these notice-driven policy pronouncements, instead predicating its claim construction on two well-established rules with which Petitioner has no quarrel: (1) Absent a determination that a patentee has chosen to be his or her own lexicographer, terms in a claim are to be given their ordinary and accustomed meaning, *see* App. 11 (citing *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) and *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F. 3d 985, 989 (Fed. Cir. 1999)); and (2) "[B]road claims supported by the written description should not be limited in their interpretation to a preferred embodiment," *see* App. 14-15 (citing *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865 (Fed. Cir. 1998)).

While each of these two canons of claim construction has a role to play, neither is preemptive. As to the plain meaning rule, this Court has instructed that a "necessarily sophisticated analysis of the whole [patent] document [is] required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole." *Markman*, 517 U.S. at 389. As to the general rule involving the relationship between a patent claim and a specific disclosed embodiment, the Federal Circuit has instructed that "whether a claim must, in any particular case, be limited to the specific embodiment presented in the specification, depends in each case on the specificity of the description of the invention and the prosecution history. These sources are evaluated as they would be understood by persons in the field of the invention." *Cultor*, 224 F.3d at 1331.

As the Federal Circuit noted in *Vitronics*, the ability of the public to consistently rely on statements in the

specification which surrender subject matter is part and parcel of the notice function of claims:

> [C]ompetitors are entitled to view the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention.

Vitronics, 90 F.3d at 1583.

In declining to grant *en banc* rehearing, the Federal Circuit abdicated its responsibility to resolve the conflict that has arisen between the panel decisions. Only this Court can remedy the problem. This Court should impose a *uniform* rule of jurisprudence to bring stability to this area of the law. This Court should determine whether or not public policy is served by a rule that the notice aspect of patent claim scope entitles a patentee to initially disclaim, surrender or relinquish subject matter in the course of distinguishing over prior art, and then recover that subject matter during claim construction either under the guise of the plain meaning rule, or by insisting that the accused infringer (or a district court) is trying to unduly restrict a claim to a preferred embodiment. Logitech believes that a patentee should have no such entitlement. The Federal Circuit, however, has left this question unresolved – an unacceptable situation of flux that this Court should remedy.

II. If This Court Decides *Festo* Without Addressing the Question Presented in this Case, the Panel Decision in *Gart* Will Create an Unresolved Issue of Patent Jurisprudence Regarding Application of the Doctrine of Equivalents.

Later this term in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed. Cir. 2000), *cert. granted*, 121 S. Ct. 2519 (2001), this Court will address the role of the prosecution history in the application of the doctrine of equivalents, and whether an amendment made during the prosecution history that narrows a patent claim and is related to patentability bars application of the doctrine of equivalents. In the present case, the panel limited the reasoning of *Festo* to the prosecution history and negated the relevance of the limiting role of the specification on the application of the doctrine of equivalents. App. 17-18. If this Court decides *Festo* but declines to decide the role of the specification on the application of the doctrine of equivalents , the public and the patent community will not know the role of the specification in determining the proper application of the doctrine of equivalents. That lack of uncertainty will prove destructive.

A. The Panel's Ruling in the Instant Case Is Inconsistent with Federal Circuit Decisions Holding that Statements in the Specification Can Bar the Application of the Doctrine Of Equivalents.

Consistent with the preeminent role that the specification plays in providing the public with notice of the nature of the invention, the Federal Circuit has held in numerous cases that statements in the specification can have

a vital role in both determining the literal scope of the claims and in the application of the doctrine of equivalents.[7] The ruling in *Gart* that statements distinguishing the prior art have no effect on the application of the doctrine of equivalents if they occur in the specification is inconsistent with these cases and undermines the notice function of the specification.

The Federal Circuit has repeatedly ruled that the claims of a patent should not be read so broadly as to encompass prior art distinguished in the specification. *SciMed*, 242 F.3d at 1343 (quoting *Ekchian*, 104 F.3d at 1304, for the proposition that "[s]ince, by distinguishing the claimed invention over the prior art, an applicant is indicating what the claims do not cover, he is by implication surrendering such protection."). In the recent *SciMed* case, the Federal Circuit interpreted the specification common to three patents-in-suit to expressly disclaim one of two possible configurations for the claimed structure. *Id.* at 1340 ("Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question."); *see also Watts v. XL Sys., Inc.*, 232 F.3d 877, 883 (Fed. Cir. 2000) (finding that "even if [the claim terms] were clear on their face, we must consult the specification to determine if the patentee redefined any of those terms."). The *SciMed* decision was based in part on statements in the written description specifically distinguishing the use of the prior art while

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[7] As stated in *Warner-Jenkinson*, the doctrine of equivalents permits extension of the claims to cover products or processes that only insubstantially differ from the literal language of the claims.

pointing out the advantages of the structures used in the subject patents. *Id.* at 1343.

Moreover, the Federal Circuit also deemed statements made in the specification to bar the application of the doctrine of equivalents. *Id.* at 1345 ("Having specifically identified, criticized, and disclaimed the dual lumen configuration, the patentee cannot now invoke the doctrine of equivalents to 'embrace a structure that was specifically excluded from the claims.'"). The Court explained that allowing the patentee to recapture subject matter explicitly disclaimed in the specification would undermine the notice function of the patent. *Id.* at 1347.

The panel's holding in the present case directly conflicts with *SciMed*.[8] If the panel had applied *SciMed*, Gart's clear surrender of subject matter in the specification would limit not only the literal scope of the claims, but also reliance on the doctrine of equivalents. *SciMed*, 242 F.3d at 1341-43.

In the instant case, Gart, in the specification, presented the "undercut curved area for the middle, ring and small fingers" as the only distinguishing feature between the prior art and his invention. The term "angular medial surface for supporting the three remaining ulnar fingers in a wrapped configuration" should not only be interpreted as requiring an undercut area around which the fingers can wrap, but should preclude reliance on the doctrine of equivalents as to any mouse not having such a structure. A holding to the contrary is incompatible with *SciMed* and the clear trend of Federal

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[8] Once again, the full Federal Circuit rejected the opportunity to decide this issue with finality. In *SciMed*, *en banc* rehearing was denied. 2001 U.S. App. LEXIS 1348 (Fed. Cir. Jan. 16, 2001).

Circuit cases on which it rests. *Id.* at 1341-42 (discussing *Watts*, 232 F.3d at 882, which held that "where the specification makes clear that the invention does not include a particular feature, that feature is outside the reach of the claims"); *see also Wang Labs, Inc. v. Am. Online, Inc.*, 197 F.3d 1377 (Fed. Cir. 1999) (stating that where the specification describes the preferred embodiment as the invention itself, "the claims are not entitled to a broader scope than that embodiment"); *Cultor*, 224 F.3d at 1328 (stating that where the specification refers explicitly to the invention as a process limited to one prepared with cytric acid catalyst, disclaimer of other prior art is effected preventing claims to be construed to cover that which was expressly disclaimed); *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1581 (Fed. Cir. 1997) (stating that where a written description expressly distinguished over prior art feature, one skilled in the art reading the claims, description, and prosecution history would conclude that the claims do not encompass that feature).

The Federal Circuit's recent decision in *J&M Corp. v. Harley-Davidson, Inc.*, No. 00-1295, -1296, -1297, 2001 U.S. App. LEXIS 23730 (Fed. Cir. Nov. 2, 2001) further solidifies this reasoning. In *J&M Corp.* a Federal Circuit panel stated that "[prior art] [s]tructure expressly disclaimed on the specification, of course, cannot be considered equivalent under the doctrine of equivalents. As noted above, the specification disclaims coverage of a single clamp structure as a flaw of prior art accessories." *Id.* at *22.

B. The Federal Circuit Ruling in the Instant Case Is Inconsistent with Supreme Court and Federal Circuit Decisions Precluding the Recapture of Claim Coverage Surrendered During Prosecution.

To preserve the notice function of the claims, both this Court and the Federal Circuit have created a body of law that precludes the recapture of claim coverage surrendered during the prosecution of the patent. In the present case, this panel undermines these holdings by providing unequal treatment based solely on the time and location of the surrender of subject matter.

In *Warner-Jenkinson*, this Court addressed infringement under the doctrine of equivalents. In upholding the doctrine of equivalents and clarifying the scope of its application, this Court emphasized that the doctrine of equivalents should be applied in a way that did not interfere with the notice function of the claims, stating,

> We do, however, share the concern of the dissenters below that the doctrine of equivalents, as it has come to be applied since Graver Tank, has taken on a life of its own, unbounded by the patent claims. There can be no denying that the doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement.

Warner-Jenkinson, 520 U.S. at 28-29.

To preserve the notice function, this Court adopted an objective element-by-element application of the doctrine, and reaffirmed the doctrine of prosecution history estoppel. Moreover, because of public-notice concerns, this Court

instituted a presumption that when a claim limitation is amended, prosecution history estoppel bars application of the doctrine of equivalents with respect to that claim limitation unless the patentee can demonstrate that the amendment was not made for purposes of patentability. *Id.* at 33-44.

In *Festo*, the Federal Circuit *en banc* expanded upon this Court's holding in *Warner-Jenkinson* and created a bright-line test under which the prosecution history may limit the scope of the doctrine of equivalents. Specifically, the Federal Circuit held that any amendment to the claims for reasons of patentability bars application of the doctrine of equivalents with respect to that claim limitation. *Festo*, 234 F.3d at 569. Moreover, to preserve the notice function of the claims, the Federal Circuit determined that this estoppel would result in an absolute bar to application of the doctrine of equivalents. *Id.*

The Federal Circuit noted the tension between the doctrine of equivalents and the notice function of the claims:

> . . . the doctrine [of equivalents] attempts to strike a balance between ensuring that the patentee enjoys the full benefit of his patent and ensuring that the claims give "fair notice" of the patent's scope. This balance can be easily upset, however, because "the doctrine of equivalents, when applied broadly, conflicts with the definitional and public notice functions of the statutory claiming requirement."

Id. at 564.

The Federal Circuit further noted that prosecution history estoppel was "one tool that prevents the doctrine of

equivalents from vitiating the notice function of the claims." *Id.*

The Federal Circuit's adoption of the absolute-bar rule in *Festo* was not without controversy, however. The *en banc* decision provoked several vigorous dissents. One such dissent included members of the *Gart* panel. Specifically, Judge Linn, concurring in part and dissenting in part, argued that the "majority's new rigid bright line rule, eliminating all flexibility in the scope afforded certain claim limitations amended for a statutory purpose, goes too far." *Id.* at 620 (Linn, J., dissenting).

Ironically, by holding that statements in the specification *do not* constitute prosecution history estoppel, and thus are irrelevant to the application of the doctrine of equivalents, the *Gart* panel has created a bright-line test for the specification that is antithetical to the bright-line test for the prosecution history created by the *en banc* majority in *Festo*.

Specifically, the *Gart* panel's dismissal of the relevance of statements made in the specification to the application of the doctrine of equivalents creates a bright-line test that vitiates the notice function of the specification. Under the panel's holding, a patentee is now free to represent in his specification that his invention is patentable because it differs from the prior art without fear that he will be held to any of those representations when later asserting infringement under the doctrine of equivalents. In contrast, *Festo* creates an absolute bar to the application of the doctrine of equivalents if the claims are narrowed for purposes of patentability during the examination process.

Thus, there are now two conflicting bright-line tests: that of *Gart* and that of *Festo*.

CONCLUSION

For the reasons stated above, this Court should grant the writ of certiorari and resolve these critical questions.

Respectfully submitted,

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APPENDIX

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

SAMUEL GART,
Plaintiff-Appellant,

v.

LOGITECH INC.,
Defendant-Appellee.

00-1088

254 F.3d 1334

June 26, 2001, Decided

COUNSEL: Joseph R. Re, Knobbe, Martens, Olson & Bear, LLP, of Newport Beach, California, argued for plaintiff-appellant. With him on the brief was William R. Zimmerman.

William L. Anthony, Orrick Herrington & Sutcliffe, LLP, of Menlo Park, California, argued for defendant-appellee. With him on the brief was Terrence P. McMahon, Eric L. Wesenberg, and Rowena Y. Young.

JUDGES: Before LOURIE, RADER, and LINN, Circuit Judges.

LINN, Circuit Judge.

On cross motions for summary judgment, the United States District Court for the Central District of California (the "district court") determined that Logitech, Inc. ("Logitech") does not infringe claim 7 of Samuel Gart's ("Gart") U.S. Patent No. 4,862,165 (the " '165 patent") either literally or under the doctrine of equivalents. *Gart v. Logitech, Inc.*, No. CV 98-5957 CBM (C.D. Cal. Aug. 16, 1999) ("*Gart I*") (claim construction and literal infringement analysis); *Gart v. Logitech, Inc.*, No. CV 98-5957 CBM (C.D. Cal. Oct. 23, 1999) ("*Gart II*") (infringement under the doctrine of equivalents analysis). The district court also determined on a motion for summary judgment that Gart's accrual of damages under 35 U.S.C. § 287(a), if any, for Logitech's TRACKMAN VISTA, TRACKMAN MARBLE, TRACKMAN MARBLE +, and TRACKMAN MARBLE FX products begins from January 30, 1997, and for Logitech's MOUSEMAN, and MOUSEMAN + products begins from July 23, 1998. *Gart v. Logitech, Inc.*, No. CV 98-5957 CBM (C.D. Cal. Aug. 18, 1999) ("*Gart III*"). Gart appeals these decisions.

We conclude that the district court erred in construing the "angular medial surface" of claim 7 to include a "ledge." Moreover, we cannot determine with certainty based on the factual record before us whether there are any genuine issues of material fact regarding infringement, either literally or under the doctrine of equivalents, by the accused products in light of our revised claim construction. Accordingly, we vacate the court's grant of summary judgment of no infringement, either literally or under the doctrine of equivalents, and remand for further proceedings.

In addition, we conclude that the district court erred in its determination of when Gart complied with the statutory

notice requirement of § 287(a) as to the TRACKMAN VISTA and MARBLE products. Thus, we reverse-in-part the district court's grant of summary judgment on this issue.

BACKGROUND

The '165 patent was issued to Gart on August 29, 1989. The technology involved relates to ergonomically shaped computer mouses for reducing muscle fatigue. Claim 7, the only claim at issue, reads as follows:

> 7. A computer input accessory apparatus of the type upon which a hand rests for selectively activating sensors generating signals for affecting operation of the computer to which the apparatus is electrically connected, the apparatus being ergonomically shaped to minimize hand fatigue; the apparatus comprising:
>
> a housing configured to receive the anterior surface of the hand and means for supporting said housing on an underlying surface;
>
> said housing having an arched metacarpal-phalangeal support surface, a concave thenar pad support surface, a distal phalange support surface for the forefinger, a distal phalange support surface for the thumb and an angular medial surface for supporting the three remaining ulnar fingers in a wrapped configuration with flexion of the distal, middle and proximal phalanges of said ulnar fingers.

'165 patent, col. 8, ll. 31-47.

In 1989, prior to the issuance of the '165 patent, Gart approached Logitech to discuss licensing the then-pending application. However, Logitech opted to forego this opportunity.

In July of 1993, Moustrak, Inc. took out a royalty-bearing license from Gart on the '165 patent. Moustrak, Inc. manufactured and sold the Colani Mouse, paying royalties to Gart under the license. Moustrak, Inc. did not mark the Colani Mouse with the *'165* patent number.

On April 5, 1995, Gart, through his patent attorney, sent a letter accompanied by the '165 patent to Logitech. The letter stated that Gart was "the holder of U.S. Patent No. 4,862,165." The letter also noted that Logitech was "selling a trackball product under the trademark TRACKMAN VISTA" and that Logitech may "wish to have [its] patent counsel examine the enclosed ['165] patent (particularly claims 7 and 8) to determine whether a non-exclusive license is needed under that patent." On May 15, 1995, Logitech's patent counsel replied to the April 5 letter noting that it had just begun a review of the patent, and that "it [would] take some time to evaluate Logitech's interest, if any, in a license under the ['165] patent."

On September 4, 1996, as a follow-up to a phone conference with Logitech, Gart, through a new patent attorney, forwarded another letter and another copy of the '165 patent to Logitech. This letter indicated that Logitech "may find the ['165] patent particularly interesting relative to [its] trackball product . . . being sold under the trademark TRACKMEN [sic-TRACKMAN] VISTA and TRACKMEN [sic-TRACKMAN] MARBLE." Logitech, through new patent counsel, responded to this letter on September 25, 1996 noting that the '165 patent "does not cover any of the

Logitech trackball products . . . [because they do not have] a concave surface (14 of Fig. 1) in combination with a flat surface (16) for resting the hypo-thenar portion of the hand . . . [or] a medial ledge surface 18 around which the fingers can be wrapped."

On January 30, 1997, Gart, through yet another patent attorney, replied to Logitech's September 25 letter. In the reply, Gart stated that he was investigating "the Logitech Vista and Marble Trackballs [sic] infringement of [the '165 patent]." The letter also asked for Logitech's explanation of how the September 25 letter "is applicable to Claim 7 . . . [which] does not recite a 'medial ledge surface 18 around which the fingers can be wrapped,' [but] rather . . . recites 'an angular medial surface for supporting the three remaining ulnar fingers in a wrapped configuration.'" On March 5, 1997, Logitech again denied that claim 7 of the '165 patent covered the VISTA and MARBLE designs, noting in particular that they did not include "an angular medial surface for supporting the three remaining fingers in a wrapped configuration with flexion of the distal, middle and proximal phalanges of the ulnar fingers (Fig. 8, items 18, 26 and 24)." (emphasis in original)

On July 23, 1998, Gart filed a complaint against Logitech alleging that Logitech's MOUSEMAN, MOUSEMAN +, TRACKMAN VISTA, TRACKMAN MARBLE, TRACKMAN MARBLE +, and TRACKMAN MARBLE FX products infringe claim 7 of the '165 patent. On May 10, 1999, Gart filed a motion for partial summary judgment of literal infringement of claim 7 of the *'165* patent. On that same day, Logitech filed a motion for summary judgment seeking limitation of damages pursuant to 35 U.S.C. § 287(a). Logitech's motion asserted that Gart failed to give notice of Logitech's alleged infringement for the TRACKMAN products until January 30, 1997 and for

the MOUSEMAN products until the complaint was filed. Logitech filed a separate motion for summary judgment of non-infringement by any of its mouse products on May 17, 1999. The court denied Gart's motion and granted both of Logitech's motions for summary judgment.

Gart timely appealed the denial of its motion regarding infringement and the granting of both Logitech's limitation of damages motion and its non-infringement motion. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

I. Standard of Review

We review the district court's grant of summary judgment de novo. *See Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 149 F.3d 1309, 1315, 47 USPQ2d 1272, 1275 (Fed. Cir. 1998). However, in reviewing a denial of a motion for summary judgment, we give deference to the district court, and "will not disturb [that] court's denial of summary judgment unless we find that the court has indeed abused its discretion." *Suntiger, Inc. v. Scientific Research Funding Group*, 189 F.3d 1327, 1333, 51 USPQ2d 1811, 1815 (Fed. Cir. 1999). When both parties move for summary judgment, the court must evaluate each motion on its own merits, resolving all reasonable inferences against the party whose motion is under consideration. *McKay v. United States*, 199 F.3d 1376, 1380 (Fed. Cir. 1999).

In considering the respective motions for summary judgment, we must decide "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." FED. R. CIV. P. 56(c);

Celotex Corp. v. Catrett, 477 U.S. 317, 322, 91 L. Ed. 2d 265, 106 S. Ct. 2548 (1986). "In determining whether there is a genuine issue of material fact, the evidence must be viewed in the light most favorable to the party opposing the motion, with doubts resolved in favor of the opponent." *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1307, 46 USPQ2d 1752, 1755 (Fed. Cir. 1998). If there are no material facts in dispute precluding summary judgment, our task is to determine whether the judgment granted is correct as a matter of law. *Prochorenko v. United States*, 243 F.3d 1359, 1362 (Fed. Cir. Mar. 23, 2001).

A determination of infringement requires a two-step analysis. "First, the claim must be properly construed to determine its scope and meaning. Second, the claim as properly construed must be compared to the accused device or process." *Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1576, 27 USPQ2d 1836, 1839 (Fed. Cir. 1993). "In order for a court to find infringement, the plaintiff must show the presence of every . . . [limitation] or its substantial equivalent in the accused device." *Wolverine World Wide, Inc. v. Nike, Inc.*, 38 F.3d 1192, 1199, 32 USPQ2d 1338, 1341 (Fed. Cir. 1994). Claim construction is an issue of law that we review de novo. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456, 46 USPQ2d 1169, 1174 (Fed. Cir. 1998) (en banc); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979, 34 USPQ2d 1321, 1322 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (1996). The determination of infringement, whether literal or under the doctrine of equivalents, is a question of fact. Bai v. L & L Wings, Inc., 160 F.3d 1350, 1353, 48 USPQ2d 1674, 1676 (Fed. Cir. 1998). An infringement issue is properly decided upon summary judgment when no reasonable jury could find that every limitation recited in the properly construed claim

either is or is not found in the accused device either literally or under the doctrine of equivalents. Id.

Like the determination of infringement, compliance with the marking statute, 35 U.S.C. § 287(a), is a question of fact, *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1111, 39 USPQ2d 1001, 1010 (Fed. Cir. 1996).Thus, this issue is properly decided upon summary judgment when no reasonable jury could find that the patentee either has or has not provided actual notice to the "'particular defendants by informing them of his patent and of their infringement of it.'" *Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 187, 30 USPQ2d 1462, 1469 (Fed. Cir. 1994) (quoting *Dunlap v. Schofield*, 152 U.S. 244, 247-48, 38 L. Ed. 426, 14 S. Ct. 576 (1894)).

II. Analysis

A. Claim Construction

"The construction of claims is simply a way of elaborating the normally terse claim language in order to understand and explain, but not to change, the scope of the claims." *Embrex, Inc., v. Serv. Eng'g Corp.*, 216 F.3d 1343, 1347, 55 USPQ2d 1161, 1163 (Fed. Cir. 2000) (internal quotations and citation omitted). Interpreting the asserted claims begins with a review of the intrinsic evidence, which consists of the claim language, the written description, and the prosecution history. *Interactive Gift Express, Inc. v. Compuserve Inc.*, 231 F.3d 859; 865, 56 USPQ2d 1647, 1652 (Fed. Cir. 2000); *Embrex*, 216 F.3d at 347, 55 USPQ2d at 1163; *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996) (noting that the claims, specification, and prosecution history are "the most significant sources of the legally operative meaning of disputed claim language."). Extrinsic evidence may be

accepted by the court to enhance its understanding of the technology. *EMI Group N. Am., Inc. v. Intel Corp.*, 157 F.3d 887, 892, 48 USPQ2d 1181, 1184 (Fed. Cir. 1998). However, extrinsic evidence cannot be used to contradict the established meaning of the claim language. *Mantech Envtl. Corp. v. Hudson Envtl. Servs., Inc.*, 152 F.3d 1368, 1373, 47 USPQ2d 1732, 1736 (Fed. Cir. 1998).

The district court construed the phrase "an angular medial surface for supporting the three remaining ulnar fingers in a wrapped configuration with flexion of the distal, middle, and proximal phalanges of said ulnar fingers" to require that the mouse housing have "an angular ledge for supporting the three remaining fingers [i.e., the middle, ring, and small fingers] in an enclosed or folded position." *Gart I*, slip op. at 5. The district court then compared each of the accused products to the claim as construed and summarily concluded that each product lacked the claimed angular medial surface either literally or equivalently. *Gart I*, slip op. at 6; *Gart* II, slip op. at 4.

Both parties suggest that the district court understood the term "angular ledge" to include a concave depression or curved undercut. We note, however, that the district court stated that "even if [it] were persuaded that . . . infringement of Claim 7 does not require a surface area called a 'curved undercut' or 'concave depression' beneath the angular medial surface, [it] finds that the . . . plain language of Claim 7 . . . requires that the angular medial surface support the middle, ring, and small fingers in an enclosed or folded configuration." *Gart II*, slip op. at 5. Thus, it is not at all clear that the district court construed the "angular ledge" to include a curved undercut or concave depression. On the other hand, what is clear from *Gart I* and *Gart II* is that the district court construed the "angular medial surface" of claim 7 to require a "ledge" and that some surface over that ledge

supports the middle, ring, and small fingers in an enclosed or folded position. For the reasons we will discuss below, we conclude that it was erroneous to construe the plain language of claim 7 to require a "ledge." Moreover, in view of that erroneous determination, it would also be erroneous to require that ledge to include a concave depression or curved undercut area.

In support of the district court's construction, Logitech asserts that to properly interpret the structure defined by the claim, which it concludes is the critical feature of the invention, the court should look to the drawings. Logitech notes that all of the drawings show that the support structure for keeping the three remaining ulnar fingers in a wrapped configuration has a ledge with an undercut area.

In addition, Logitech asserts that the written description particularly describes the invention as having a "medial ledge undercut" to support the three remaining ulnar fingers, and that this reference is not related to a preferred embodiment. Moreover, Logitech notes that Gart distinguished his invention in the *'165* patent specification from three prior art references and in so doing stated that those references fail to set forth an undercut area for the middle, ring, and small fingers. Logitech also contends that this distinction over the prior art was critical to the United States Patent and Trademark Office's decision that claim 7 was patentable. In this regard, Logitech notes that the examiner's reasons for allowance state: "the prior art fails to teach the details on the shape and surfaces of the hand controller taught by the instant claims."

None of Logitech's arguments persuades us that the district court's claim construction was correct. Logitech is certainly correct that claims do not have meaning removed

from the context from which they arose, i.e., "the claims are directed to the invention that is described in the specification." *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352, 58 USPQ2d 1076, 1079 (Fed. Cir. 2001). In addition, it is certainly correct that the specification and the prosecution history should be consulted to construe the language of the claims. However, we perform this consultation to determine if the patentee has chosen to be his or her own lexicographer, *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (noting that claim terms may be defined by the patentee in the specification as long as such defining is done with reasonable clarity, deliberateness, and precision), *Watts v. XL Sys., Inc.*, 232 F.3d 877, 882, 56 USPQ2d 1836, 1839 (Fed. Cir. 2000) (noting that distinguishing remarks contained in both the specification and in the prosecution history contributed to finding that the patentee had narrowed the construction of the sealingly connected limitation); *Southwall Techs., Inc. v. Cardinal IG, Co.*, 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1676 (Fed. Cir. 1995) (noting that arguments and amendments made during the prosecution of a patent application and other aspects of the prosecution history, must be examined to determine the meaning of terms in the claims because claims may not be construed one way in order to obtain their allowance and in a different way against accused infringers), or when the language itself lacks sufficient clarity such that there is no means by which the scope of the claim may be ascertained from the language used, *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1554, 42 USPQ2d 1737, 1741 (Fed. Cir. 1997), *overruled on other grounds by Cybor*, 138 F.3d 1448, 46 USPQ2d 1169. However, when the foregoing circumstances are not present, we follow the general rule that terms in the claim are to be given their ordinary and accustomed meaning. *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50

USPQ2d 1607, 1610 (Fed. Cir. 1999).[1] "In short, a court must presume that the terms in the claim mean what they say, and, unless otherwise compelled, give full effect to the ordinary and accustomed meaning of claim terms." *Id.*

Contrary to Logitech's assertion, the '165 patent specification does not describe "the invention" as having a "medial ledge undercut to support the middle, ring and small fingers of the hand." '165 patent, col. 3, ll. 29-36. This portion of the specification merely exemplifies one embodiment of the invention that would provide "a great deal of comfort." *Id.* The specification clearly states that the provision of "an angular medial surface" for supporting the remaining three ulnar fingers in a wrapped configuration will achieve the object of the invention, i.e., an ergonomic design of a hand controller apparatus that minimizes hand fatigue. *Id.* at col. 3, l. 60-col. 4, l. 3. Furthermore, the description at column 5, lines 29-34, to which the district court referred in construing claim 7 to include a ledge, is merely a description of the preferred ergonomic design that minimizes hand fatigue.

Admittedly, the drawings show a controller housing having an angular ledge with a concave or flat undercut area over which the three remaining ulnar fingers must be wrapped. However, the '165 patent presents these drawings only to depict the preferred embodiment. *Id.* at col. 4, l. 15-col. 6, l. 46. These drawings are not meant to represent "the" invention or to limit the scope of coverage defined by the words used in the claims themselves. In view of the foregoing, we conclude that the entirety of the specification

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[1] Of course, "[a] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty." *See Renishaw PLC v. Marposs Societa per Azioni*, 158 F.3d 1243, 1250, 48 U.S.P.Q.2D (BNA) 1117 (Fed. Cir. 1998).

describes several embodiments of an ergonomic hand controller, including a controller with an angular medial ledge, a controller with an angular medial ledge having an undercut area, and a controller with an angular medial surface. The written description does not explicitly limit the subject matter of the patent to the ledge configuration set forth in the drawings.

We acknowledge that Gart made statements at column 2, lines 28-63 of the specification distinguishing the prior art, noting in particular that at least three of the references did not include the "undercut curved areas." However, Gart also notes in the specification that the "prior art [that has attempted to provide specially shaped hand engaging surfaces] either [does] not provide the full ergonomic surface design of the present invention or [is] simply incompatible with the surface shapes needed in a hand controller as opposed to other hand-related applications." *Id.* at col. 2, ll. 18-26.

Moreover, we also note that Gart indicates in the specification that this undercut feature that the prior art does not have is a feature of the preferred embodiment. Id. at col. 5, ll. 34-43. From the foregoing, we conclude that Gart distinguished his preferred embodiment from particular prior art references on the basis of its undercut feature: but, Gart also noted that those same references did not contain all of the ergonomic surface features of the invention or were incompatible with the surface shapes needed in a hand controller. In other words, Gart did not in any way limit all of his claims to a controller with an angular medial ledge by the remarks distinguishing the prior art.

Finally, we do not agree with Logitech that the examiner expressly allowed the claims because "an undercut area" was novel and non-obvious. It is undisputed that the

examiner remarked that "claims 1 and 7 recite a hand controller . . . apparatus having various surfaces and shaped in order to provide support to various parts of a user's hand operating the device to minimize hand fatigue." Moreover, the examiner asserted that "the details on the shape and surfaces . . . taught by the claims" were not taught by the prior art. However, the examiner never stated that the patentable difference over the prior art was "the concave undercut area" of the claimed device. We note that drawing inferences of the meaning of claim terms from an examiner's silence is not a proper basis on which to construe a patent claim. *DeMarini Sports, Inc., v. Worth, Inc.*, 239 F.3d 1314, 1326, 57 USPQ2d 1889, 1896 (Fed. Cir. 2001).

We conclude that the '165 patent does not attribute a special meaning to the phrase "angular medial surface," and there were no express representations made in obtaining the patent regarding the scope and meaning of the claim terms. Moreover, the scope of claim 7 may be ascertained from the plain language of that claim. Thus, we cannot sustain the district court's interpretation of the claim language "angular medial surface" as requiring "an angular medial ledge." Such a construction would improperly add a limitation appearing in the specification and the drawings, but not appearing in the unambiguous language of the claim. *See Intervet Am., Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989) (noting that "courts cannot alter what the patentee has chosen to claim as his invention"); *Southwall*, 54 F.3d at 1576, 34 USPQ2d at 1676; *Wang Labs., Inc. v. Am. Online, Inc.*, 197 F.3d 1377, 1383, 53 USPQ2d 1161, 1165 (Fed. Cir. 1999); *Modine Mfg. Co. v. United States Int'l Trade Comm'n*, 75 F.3d 1545, 1551, 37 USPQ2d 1609, 1612 (Fed. Cir. 1996). Moreover, it is well established that broad claims supported by the written description should not be limited in their interpretation to a preferred embodiment, *e.g.*, *Laitram Corp. v. Cambridge*

Wire Cloth Co., 863 F.2d 855, 865, 9 USPQ2d 1289, 1299 (Fed. Cir. 1988) ("References to a preferred embodiment, such as those often present in a specification, are not claim limitations."), which we deem to be the case here. Rather, the terms of the phrase "angular medial surface for supporting . . . in a wrapped configuration with flexion" must be given their ordinary meaning.

We adopt the ordinary definitions of the terms "wrapped" and "flexion," i.e., "to enclose . . . or to surround" and "partially bent," respectively, proffered by Gart because they are standard dictionary definitions that Logitech does not dispute. The parties do not dispute that "the three remaining ulnar fingers" refers to the middle, ring, and small fingers. The parties do not proffer an ordinary definition of the remaining terms. The ordinary definition of the term "angular" and "surface" means "having one or more angles," and "the exterior or upper boundary of an object or body," respectively. WEBSTER'S NEW COLLEGIATE DICTIONARY 45, 1172 (1975). Moreover, as for the phrase "distal, middle, and proximal phalanges," we take judicial notice that this refers to the bones of the fingers from the tip down to, but not including, the palm.

Therefore, we conclude that "an angular medial surface for supporting the three remaining ulnar fingers in a wrapped configuration with flexion of the distal, middle, and proximal phalanges of said ulnar fingers" merely requires an angled surface that supports the middle, ring, and small fingers in a folded position such that the distal, middle and proximal bones of the fingers are partially bent over that angled surface. We note that the foregoing definition does not require that the middle, ring, and small fingers be supported on the surface such that they are folded under.

B. Infringement

After claim construction, the next step in an infringement analysis is comparing the properly construed claims with the allegedly infringing devices. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1360, 54 USPQ2d 1308, 1312 (Fed. Cir. 2000). This comparison is a question of fact. *Id.* Thus, if we agree with the district court that there are no genuine issues of material fact, and the movant is entitled to judgment as a matter of law, we can affirm the district court's grant of summary judgment. FED. R. CIV. P. 56(c); *Celotex*, 477 U.S. at 322; *see also Vehicular Techs. Corp. v. Titan Wheel Int'l, Inc.*, 212 F.3d 1377, 1381, 54 USPQ2d 1841, 1843 (Fed. Cir. 2000) (holding that a fact issue is not in genuine dispute if a reasonable jury could only find in favor of the moving party).

In its literal infringement analysis, the district court did not discuss the structure of the accused products except to summarily conclude that none of them has "an angular medial surface for supporting the three remaining ulnar fingers in an enclosed or folded configuration." *Gart I,* slip op. at 6-7. The court, likewise, summarily concluded that none of the accused products has "an equivalent angular medial surface area shaped for supporting the three remaining ulnar fingers in a wrapped configuration" and thus these products do not infringe claim 7 under the doctrine of equivalents. *Gart II*, slip. op. at 5.

In support of the district court's conclusion, Logitech contends that there is no infringement by any of its accused products since they do not contain an undercut area for the middle, ring, and small fingers such that the "angular medial ledge" would support those fingers in a wrapped

configuration, or any equivalent ledge structure.[2] In addition, Logitech contends that to the extent that any fingers do traverse a medial area on its accused products, in no circumstances is the middle finger supported on this medial area. We cannot agree with Logitech's reasoning that summary judgment of noninfringement was properly granted by the district court. Logitech's assertions of noninfringement, like the district court's conclusions, are premised on an erroneous construction of claim 7. As set forth in the claim construction above, claim 7 does not require an "angular medial ledge." Rather, the angular medial surface required by claim 7 calls for an angled surface that supports the middle, ring, and small fingers in a folded position such that the distal, medial, and proximal phalangeal regions of those fingers are partially bent over that surface, without necessarily being folded under.

Gart contends that while the district court's grant of summary judgment of no infringement rests on an erroneous claim construction and should be vacated for that reason alone, this court can find, as a matter of law, that the accused products satisfy the literal requirements of claim 7 because the structure of Logitech's accused products is undisputed.

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[2] As discussed in the claim construction section above, Logitech notes that Gart distinguished his invention in the '165 patent specification from three prior art references. Logitech contends that these are remarks made in the prosecution history of the '165 patent. However, we note that the specification in and of itself is not part of the "prosecution history." Moreover, since such remarks are part of the specification and not part of the prosecution history, they are not relevant to an evaluation of whether or not prosecution history estoppel bars a finding of infringement under the doctrine of equivalents as set forth in the court's majority opinion in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000), *cert. granted*, 69 U.S.L.W. 3673 (U.S. June 18, 2001) (No. 00-1543).

While we agree with Gart that the structure per se of the accused products is undisputed, we cannot determine with certainty based on those structures whether there are any genuine issues of material fact regarding the manner in which the angled surfaces of these products support the middle, ring, and small fingers. The district court's opinion that the accused devices do not literally infringe claim 7 or infringe that claim under the doctrine of equivalents simply states that conclusion without providing any reasoning, and thus, does not aid us in this regard. Accordingly, we vacate the district court's judgment of noninfringement and remand for further proceedings consistent with this opinion.

Should the district court need to reach the issue of infringement under the doctrine of equivalents, we note that while claim 7 literally requires an angled surface that supports the three remaining ulnar fingers in a folded position such that the distal, medial, and proximal phalangeal regions are partially bent over that angled surface, there is nothing to preclude an analysis of whether or not the accused devices include an equivalent element that performs substantially the same function in substantially the same way to achieve substantially the same result or otherwise differs only insubstantially.

III. Limitation of Damages

When a patented article has been produced by a patentee or its licensee, the amount of damages the patentee can recover in an infringement suit is statutorily limited to those acts of infringement that occurred after the patentee gave the alleged infringer "notice of infringement." 35 U.S.C. § 287(a) (1994). The statute permits either constructive notice, which is accomplished by marking the article with the patent number, or actual notice. The requirement of actual notice is designed to assure that the

accused infringer knew of the adverse patent and the alleged infringement during the period in which its liability accrues. *SRI Int'l, Inc. v. Advanced Tech. Labs.*, Inc., 127 F.3d 1462, 1470, 44 USPQ2d 1422, 1428 (Fed. Cir. 1997).

The parties agree that the Colani Mouse, sold by Gart's licensee but not marked with the *'165* patent number, was a patented article within the meaning of *35 U.S.C. § 287*(a), thus subjecting Gart to the actual notice requirement of *35 U.S.C. § 287*(a). While the parties do not dispute the factual content of the April 5, 1995 (the "1995 letter"), September 4, 1996 (the "1996 letter"), or January 30, 1997 (the "1997 letter") letters, they dispute which of these letters effected actual notice.

We addressed the statutory requirement of actual notice in Amsted, stating that mere "notice of the patent's existence or ownership" is not "notice of the infringement," and as such would be insufficient to comply with section 287(a). 24 F.3d at 187, 30 USPQ2d at 1469. We concluded that "affirmative communication [to the alleged infringer] of a specific charge of infringement by a specific accused product or device" is required to comply with section 287(a). *Id.*

The district court concluded that actual notice of infringement of the TRACKMAN MARBLE and TRACKMAN VISTA products occurred with the 1997 letter, and, as to the remaining products, the requirement was met by Gart's filing of its infringement suit. In the district court's opinion, the 1995 letter was insufficient notice because it did not inform Logitech of the "activity" believed to be an infringement, and the 1996 letter was insufficient because it did not indicate Gart's belief that the TRACKMAN VISTA and MARBLE products were infringing.

In support of the district court's decision, Logitech contends that the 1995 and 1996 letters, which do not use the word "infringement," are insufficient actual notice because they were at best an invitation for Logitech to study the patent and to determine for itself whether there might be an infringement. This argument and the district court's findings are reminiscent of the argument made by appellant and rejected by this court in SRI, namely that notice was insufficient without an unqualified charge of infringement and a threat of suit. 127 F.3d at 1470, 44 USPQ2d at 1428.

In SRI, we stated that "[informing the alleged infringer] of the identity of the patent and the activity that is believed to be an infringement, accompanied by a proposal to abate the infringement, whether by license or otherwise" complies with the actual notice requirement of the marking statute. *Id.* (distinguishing the criteria for actual notice from the criteria for filing a declaratory judgment action, which requires a threat of suit). In other words, in SRI we explained that as long as the communication from the patentee provides sufficient specificity regarding its belief that the recipient may be an infringer, the statutory requirement of actual notice is met. *Id.* Thus, the requirement of "a specific charge of infringement" set forth in Amsted does not mean the patentee must make an "unqualified charge of infringement."

Determining whether the patentee's communication provides "sufficient specificity" regarding its belief that the recipient may be an infringer cannot take into consideration the knowledge or understanding of the alleged infringer, but must focus on the action of the patentee. *Amsted*, 24 F.3d at 187, 30 USPQ2d at 1469 ("it is irrelevant . . . whether the defendant knew of . . . his own infringement"). Therefore, contrary to assertions by Gart, whether or not the alleged

infringer subjectively believed that the patentee's letter was a charge of infringement has no bearing on the adequacy of notice.

Based on our review of the record before us, we hold that the district court erroneously found that neither the 1995 letter nor the 1996 letter effected actual notice under section 287(a), at least as to the products referenced in those letters. Moreover, because there is no dispute over the contents of the letters, as we will discuss below, we conclude that no reasonable jury could find that Gart failed to comply with section 287(a) as to the TRACKMAN VISTA products in the 1995 letter and as to the TRACKMAN MARBLE products in the 1996 letter.

The 1995 letter to Logitech included a specific reference to claims 7 and 8 of the '165 patent, specific reference to Logitech's selling of the TRACKMAN VISTA, and noted that Logitech "may wish to have [its] patent counsel examine the . . . patent . . . to determine whether a non-exclusive license under the patent is needed." The whole point of offering a license is to insulate a licensee from infringement charges by the licensor. *C.R. Bard, Inc. v. Schwartz*, 716 F.2d 874, 879, 219 USPQ 197, 202 (Fed. Cir. 1983). Thus, from an objective standpoint, the clear inference from the 1995 letter's reference to specific claims of the patent, a specific product, and the suggestion that a license under the patent may be needed is that Gart believed the TRACKMAN VISTA infringed claims 7 and 8 of the *'165* patent. Moreover, it would be rare indeed for a letter such as the 1995 letter not to be considered by its recipient as more than a "mere" invitation to determine for itself whether there was infringement. However, whether or not this letter also invited Logitech to study the patent and to determine for itself whether there might be an infringement of the '165 patent is irrelevant to the clear inference that Gart believed

Logitech's VISTA infringed claims 7 and 8. Thus, we conclude that no reasonable jury could find that Logitech was not notified by the 1995 letter of the infringement of its TRACKMAN VISTA products because that letter reasonably suggests to Logitech that Gart believed the making and selling of the TRACKMAN VISTA infringed at least claims 7 and 8 of the '165 patent. The notice thus satisfies the conditions of section 287(a).

The 1996 letter included another copy of the *'165* patent to Logitech and indicated that Logitech might find that patent "particularly interesting" relative to Logitech's TRACKMAN VISTA and TRACKMAN MARBLE products. Standing alone, this letter would not constitute effective actual notice because it does not reasonably convey that Gart believed Logitech was infringing the '165 patent by making and selling the VISTA and MARBLE products. However, the 1996 letter was not the first communication between Gart and Logitech regarding the *'165* patent claims. As we noted above, the 1995 letter reasonably establishes Gart's belief that Logitech's manufacture and sales of at least the VISTA computer controllers may infringe claims of the '165 patent. In view of these circumstances, we conclude that no reasonable jury could find that Logitech was not notified of the infringement of its TRACKMAN MARBLE products, pursuant to section 287(a), by the 1996 letter because that letter in conjunction with the 1995 letter reasonably apprises Logitech that Gart believed that the making and selling of the MARBLE products infringed the '165 patent.

Consequently, we reverse the district court's finding that Gart did not effect actual notice of infringement of the TRACKMAN VISTA, MARBLE, MARBLE +, and MARBLE FX to Logitech until January 30, 1997. We conclude that no reasonable jury could find that Logitech

was not "notified of infringement pursuant to section 287(a)" as to its TRACKMAN VISTA product as of April 5, 1995, and as to its TRACKMAN MARBLE, MARBLE +, and MARBLE FX products as of September 4, 1996. However, the district court's finding that Gart did not effect actual notice of infringement of the TRACKMAN MOUSEMAN and MOUSEMAN + until Gart filed its complaint on July 23, 1998 is affirmed.

CONCLUSION

For the reasons set forth above, we vacate the district court's grant of summary judgment in favor of Logitech as to no infringement of claim 7, either literally or under the doctrine of equivalents, and remand for a determination of infringement based on the claim as construed herein. Moreover, we reverse the district court's grant of summary judgment in favor of Logitech as to the limitation of damages regarding Logitech's TRACKMAN VISTA, MARBLE, MARBLE +, and MARBLE FX products. However, we affirm the district court's grant of summary judgment in favor of Logitech as to the limitation of damages regarding Logitech's TRACKMAN MOUSEMAN and MOUSEMAN + products.

AFFIRMED-IN-PART, VACATED-IN-PART, REVERSED-IN-PART, AND REMANDED

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

SAMUEL GART,
Plaintiff,

v.

LOGITECH, INC.,
Defendant.

Case No. cv 98-5957

ORDER RE: PLAINTIFF'S MOTION FOR PARTIAL SUMMARY JUDGMENT ON LITERAL INFRINGEMENT OF PATENT NO. 4,862,165 AND DEFENDANT'S MOTIONS FOR PARTIAL SUMMARY JUDGMENT ON NONINFRINGEMENT OF PATENT NO. 4,862,765 BY TRACKBALL, AND NONINFRINGMENT OF PATENT NO. 4,862,165

The matter before this Court, the Honorable Consuelo B. Marshall, United States District Judge presiding, is Plaintiff's motion for partial summary judgment on literal infringement of Patent No. 4,862,165, Defendant's motion for partial summary judgement on non-infringement of Patent No. 4,862,165 by Trackball, and Defendant's motion for summary judgement on non-infringement of Patent No. 4,862,165.

JURISDICTION

The Court has jurisdiction over this matter pursuant to 28 U.S.C. § 1331.

BACKGROUND AND PROCEDURAL HISTORY

On August 29, 1989, the United States Patent Office issued Patent No. 4,862,165 ("the '165 Patent") to Plaintiff Samuel Gart ("Plaintiff"). On April 5, 1995, Plaintiff forwarded a letter, along with a copy of the '165 Patent, to Defendant suggesting that Defendant consider whether there is a need for a nonexclusive license. Thereafter, the parties exchanged correspondence regarding Defendant's Trackman Vista and Trackman Marble products until Plaintiff forwarded a letter, dated January 30, 1997, informing Defendant that the trackball Vista and Marble products infringe Claim 7 of the '165 Patent (the "January 30, 1997 letter").

On July 23, 1998, Plaintiff filed a complaint against Defendant Logitech, Inc. ("Defendant") alleging that Defendant has in the past and is currently infringing the '165 Patent by marketing and selling "computer mouse products embodying the patented invention." On May 10, 1999, Plaintiff filed the present motion for partial summary judgment on literal infringement of the '165 Patent. Plaintiff contends that Defendant's Mouseman, Mouseman +, Trackman, Trackman Marble, Trackman Marble +, and Trackman Marble FX (collectively the "Accused Products") infringe Claim 7 of the '165 Patent. On May 17, 1999, Defendant filed two motions for whole and/or partial summary judgment seeking judgment of 1) non-infringement of Defendant's trackball products; and 2) non-infringement by Defendant's products, including the "trackball" and "mouse" products.

The '165 Patent

The '165 Patent describes a computer hand controller, such as a mouse, which is ergonomically shaped

to support the user's hand. The '165 Patent provides for eight claims. Plaintiff contends that Claim 7 is the only claim at issue. Claim 7 of the '165 Patent describes a computer input accessory apparatus of the type upon which a hand rests for selectively activating sensors generating signals for affecting operation of the computer to which the apparatus is electronically connected, the apparatus being ergonomically shaped to minimize hand fatigue; the apparatus comprising:

1) a house configured to receive the anterior surface of the hand and means for supporting said housing on an underlying surface; and
2) said housing having:
   - an arched metacarpal-phalangeal support surface,
   - a concave thenar pad support surface,
   - a distal phalange support surface for the forefinger,
   - a distal phalange support surface for the thumb, and
   - an angular medial surface for supporting the three remaining ulnar fingers in a wrapped configuration with flexion of the distal, middle and proximal phalanges of said ulnar fingers.

Patent No. 4,862,165, col. 8:31-47.

STANDARD OF LAW

Summary judgement may be granted when "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." FED. R. CIV. P.56(c). In a motion for summary judgment, if the moving party meets its initial burden of identifying for the court those portions of the materials on file that it believes demonstrates the absence of any genuine issues of

material fact, the burden of production then shifts so that the non-moving party must set forth, by affidavit or as otherwise provided in Rule 56, specific facts showing that there is a genuine issue for trial. *Celotex Corp. v. Catrett*, 477 U.S. 317,324 (1986); *T.W. Elec. Serv., Inc. v. Pacific Elec. Contractors Ass'n*, 809 F.2d 626, 630 (9th Cir. 1987). If the factual context makes the non-moving party's claim implausible, that party must come forward with more persuasive evidence than would otherwise be necessary to show that there is a genuine issue for trial. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986); *California Architectural Bldg. Prods., Inc. v. Franciscan Ceramics, Inc.*, 818 F.2d 1466, 1468 (9th Cir. 1987), *cert. denied*, 484 U.S. 1006 (1988). If the non-moving party bears the burden of proof with respect to an element essential to the case, and that party fails to make a sufficient showing to establish a genuine dispute of fact with respect to the existence of the element, summary judgement is appropriate. *Celotex*, 477 U.S. at 317; *California Architectural*, 818 F.2d at 1468.

DISCUSSION

I. Literal Infringement - 35 U.S.C. § 271(a)

Plaintiff contends that Defendant's "Trackman" and "Mouseman" products literally infringe the '165 Patent in violation of section 35 U.S.C. § 271(a). Section 271(a) provides that "whoever without authority makes, uses or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent." 35 U.S.C. § 271(a). Determining whether a patent claim has been infringed requires a two-step analysis. First, the claim must be properly construed to determine its scope and meaning. *Vehicular Technologies*, 141 F.3d at 1087; *Carroll*

Touch, Inc. v. Electro Mechanical Sys., Inc., 15 F.3d 1573, 1576 (Fed. Cir. 1993). Second, the claim as properly construed must be compared to the accused product or process. *Carroll Touch*, 15 F.3d at 1576.

A. Claim Construction

Claim construction is a matter of law for the trial court. *Markman v. Westview Instruments, Inc.*, 116 St. Ct. 1384, 1393 (1996). "It is well-settled that in interpreting an asserted claim, the court should look to the intrinsic evidence of record, i.e., the patent itself, including the claims, the written description portion of the specification and, if in evidence, the prosecution history. Such intrinsic evidence is in the most significant source of the legally operative meaning of disputed claim language." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (citations omitted). Reliance on extrinsic evidence to interpret claims is proper only when claim language "remains genuinely ambiguous after consideration of the intrinsic evidence." *Bell & Howell Document Mgmt. Prod. Co. v. Altek Systems*, 132 F.3d 701, 706 (Fed. Cir. 1997). Such evidence should be used only to aid the court in "coming to the proper understanding of the claims" and the technology involved. *Vitronics*, 90 F.3d at 1583. Courts must be careful to merely understand and explain the scope of the patent, and not to transform or expand that scope during construction. *Scripps Clinic & Res. Found v. Genetech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

The '165 patent states that the critical features of the invention reside in the shape of the housing. The shape of the housing embodies essentially three elements: 1) an arched metacarpel-phalangeal support surface; 2) a distal phalange support surface for the volar pads of the thumb and forefinger; and 3) a medial ledge for supporting the three

remaining ulnar fingers in a wrapped configuration of the distal, middle, and proximal phalanges. Patent No. 4,862,165, col. 8:40-48. The '165 Patent fails to define the terms, "metacarpal-phalangeal," "thenar," "distal phalange," "middle phalange," "proximal phalange," "volar pads," "ulnar fingers," or "wrapped configuration," therefore, in order to construe Claim 7 of the '165 Patent, the Court must look to extrinsic evidence to define these terms.

Plaintiff offers figures 2.4 and 2.15 from Derek Field, *Anatomy: Palpation and Surface Markings* (Butterworth-Heinemann, 2d ed., 1997), depicting the bones of the human hands, and figure 16.10 from Churchill Livingston, *Grays Anatomy* (38th ed., 1995), depicting the surface anatomy of the upper limb. Plaintiff also offers anatomical definitions from *Dorlands Illustrated Medical Dictionary* (W.B. Saunders Co. 28th ed., 1994), to define the anatomical terms presented in Claim 7. Finally, Plaintiff offers excerpts from *Random House Dictionary* (2d ed., 1987), defining the term "wrapped" within the phrase "wrapped configuration." Based on the evidence, this Court construes Claim 7 of the '165 Patent to cover a hand controller with a support surface for the palm area of the user's hand, a support surface for the thumb and thumb pad, a support surface for the forefinger that allows the forefinger to be in a bent position, and an angular ledge for supporting the three remaining fingers in an enclosed or folded position.

B. Comparing the Accused Products to the Construed '165 Patent

1. Defendant's motion for partial summary judgment on non-infringement of Patent No. 4,862,165 by Trackball

Defendant contends that Claim 7 of the '165 Patent describes and claims a housing for a computer mouse that facilitates its movement across a flat surface because the description of prior art in the '165 Patent refers to a hand controller, commonly called a "mouse," that is moveable over a flat surface. Defendant contends that its trackball products cannot infringe on the '165 Patent as a matter of law because they are designed to be stationary and do not move across a flat surface. Although the description of prior art refers to moveable hand controllers, the language of Claim 7 does not refer to either moveable, or stationary, hand controllers in describing the physical configuration of the claimed housing. Thus, Defendant is not entitled to judgment of non-infringement by "Trackball" as a matter of law on the theory that Defendant's trackball products do not infringe the '165 Patent because they are designed to be stationary.

2. Literal Infringement of Patent No. 4,862,165

Plaintiff moves for partial summary judgment of literal infringement of the '165 Patent as to the Accused Products. Defendant moves for summary judgment of non-infringement of the '165 Patent by Defendant's products.[1] Since determination of Plaintiff's motion and Defendant's motion involve the same or substantially identical questions of law, this Court will consider these motions together.

Literal infringement requires that the accused product or process embody every element of the patent claim. *Mannesmann Demag Corp. v. Engineered Metal Prods. Co.*,

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[1] Although Defendant seeks summary judgment on non-infringement of the '165 Patent by Defendant's products, the only products before this Court are those products identified as the Accused Products.

793 F.2d 1279, 1281 (Fed. Cir. 1986). Defendant contends that its products, including the 'trackball" and "mouse" products, do not infringe the '165 Patent because they do not have a ledge that allows for wrapping of the remaining ulnar fingers. Plaintiff contends that Defendant's products infringe Claim 7 of the '165 Patent because the Accused Products embody all of the elements described in Claim 7. Plaintiff argues that infringement only requires an angular surface, not a ledge or a concave, yet Plaintiff offers evidence showing that the term "wrapped" means "to enclose in something wound or folded about . . . wind, fold, or bind ... to surround, envelop, shroud, or hide." Thus, the language of Claim 7 requires something more than an angular surface. Claim 7 requires that the angular surface support the three remaining ulnar fingers in a folded and/or enclosed configuration.

Plaintiff provides the Court with a hand controller manufactured by one of Plaintiff's licensees. Exhibit 44A, as a demonstrative exhibit to support the contention that the Accused Products, similar in appearance to the licensed product, infringe on the '165 Patent. The willingness of a third party to become a licensee does not address the issue of literal infringement of the '165 Patent by the Accused Products as the law requires that the Court compare the Accused Products to the construed '165 Patent. *Carroll Touch*, 15 F.3d at 1576.

Plaintiff has not manufactured a product under the '165 Patent, but provides the Court with a prototype of the '165 Patent, Exhibit 502, as a demonstrative exhibit. In comparing Plaintiff's prototype with the construed Claim 7 of the '165 Patent, this Court finds that the angular surface of the prototype with the construed Claim 7 of the '165 Patent, this Court finds that the angular surface of the prototype supports the three remaining ulnar fingers in a folded or

enclosed configuration consistent with the limitations in Claim 7.

In comparing each of the Accused Products with the construed Claim 7 of the '165 Patent, this Court finds the following:

i. *Plaintiff's Exhibit 47 - "Mouseman"*

The accused Mouseman product does not have a support surface for the thumb or thumb pad, or an angular medial surface for supporting the three remaining ulnar fingers in an enclosed or folded configuration. Thus, this Court concludes that the accused Mouseman product does not literally infringe Claim 7 of the '165 Patent.

ii. *Plaintiff's Exhibit 48 - "Mouseman +"*

The accused Mouseman + product does not have a support surface for the thumb or thumb pad, or an angular medial surface for supporting the three remaining ulnar fingers in an enclosed or folded configuration. Thus, this Court concludes that the accused Mouseman + product does not literally infringe Claim 7 of the '165 Patent.

iii. *Plaintiff's Exhibit 46 - "Trackman Vista (Trackman)"*

The accused Trackman product does not have an angular medial surface for supporting the three remaining ulnar fingers in an enclosed or folded configuration. Thus, this Court concludes that the accused Trackman product does not literally infringe Claim 7 of the '165 Patent.

iv. *Plaintiff's Exhibit 49 - "Trackman Marble"*

The accused Trackman Marble product does not have a support surface for the thumb or thumb pad, or an angular medial surface for supporting the three remaining ulnar fingers in an enclosed or folded configuration. Thus, this Court concludes that the accused Trackman Marble product does not literally infringe Claim 7 of the '165 Patent.

v. *Plaintiff's Exhibit 50 - "Trackman Marble +"*

The accused Trackman Marble + product does not have a support surface for the thumb or thumb pad, or an angular medial surface for supporting the three remaining ulnar fingers in an enclosed or folded configuration. Thus, this Court concludes that the accused Trackman Marble + product does not literally infringe Claim 7 of the '165 Patent.

vi. *Plaintiff's Exhibit 51 - "Trackman Marble FX"*

The accused Trackman Marble FX product does not have an angular medial surface for supporting the three remaining ulnar fingers in an enclosed or folded configuration. Thus, this Court concludes that the accused Trackman Marble FX product does not literally infringe Claim 7 of the '165 Patent. Accordingly, Defendant is entitled to summary judgment as to each of the Accused Products.

II. Defendant's Objections to Plaintiff's Evidence

Defendant objects to Plaintiff's Exhibits 1, 2, 4, 7-10, 15, 16, 18-20, 22-27, 30, 32-36, 38-42. Plaintiff offers

extrinsic evidence in support of its motion for summary judgment on literal infringement. Extrinsic evidence should be used only to aid the court in "coming to the proper understanding of the claims" and the technology involved. Vitronics, 90 F.3d at 1583. Accordingly, this Court has not considered Plaintiff's extrinsic evidence, except for Exhibits 7-9, 30, 39-42, for the purposes of construing the '165 Patent; therefore, this Court OVERRULES Defendant's objections as to these exhibits.

CONCLUSION

Based on the foregoing findings of fact and conclusions of law, this Court DENIES Defendant's motion for partial summary judgment on non-infringement of Patent No. 4,862,165 by "Trackball" as to Defendant's theory that trackball products cannot infringe on the '165 Patent as a matter of law because they are designed to be stationary. This Court DENIES Plaintiff's motion for partial summary judgment on literal infringement of Patent No. 4,862,165 as to the Accused Products; and GRANTS Defendant's motion for summary judgment on non-infringement of Patent No. 4,862,165 as to the Accused Products.

IT IS SO ORDERED

DATED: August ___, 1999

CONSUELO B. MARSHALL
United States District Judge

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

SAMUEL GART,
Plaintiff,

v.

LOGITECH, INC.,
Defendant.

Case no. cv 98-5957

ORDER: GRANTING DEFENDANT'S MOTION FOR SUMMARY JUDGMENT ON NONINFRINGMENT OF PATENT NO. 4, 862, 165 UNDER DOCTRINE OF EQUIVALENTS

The matter before this Court, the Honorable Consuelo B. Marshall, United States District Judge, presiding, is Defendant Logitech, Inc.'s motion for summary judgment on noninfringement of Patent No. 4,862,165.

JURISDICTION

This Court has jurisdiction over this matter pursuant to 28 U.S.C. § 1331.

BACKGROUND AND PROCEDURAL HISTORY

On August 29, 1989, the United States Patent Office issued Patent No. 4,862,165 ("the '165 Patent") to Plaintiff Samuel Gart ("Plaintiff"). On April 5, 1995, Plaintiff forwarded a letter, along with a copy of the '165 Patent, to Defendant Logitech, Inc. ("Defendant") suggesting that

Defendant consider whether there is a need for a nonexclusive license. Thereafter, the parties exchanged correspondence regarding Defendant's Trackman products until Plaintiff forwarded a letter, dated January 30, 1997, informing Defendant that its Trackman products infringe Claim 7 of the '165 Patent. On July 23, 1998, Plaintiff filed a complaint alleging infringement of the '165 Patent. On May 10, 1999, Plaintiff filed a motion for partial summary judgment on literal infringement of Claim 7 of the '165 Patent as to Defendant's Mouseman, Mouseman +, Trackman, Trackman Marble, Trackman Marble +, and Trackman Marble FX products (collectively the "Accused Products"). On May 17, 1999, Defendant filed two motions for partial summary judgment of non-infringement by Defendant's trackball products, and summary judgment of non-infringement by Defendant's products, including the "trackball" and "mouse." On August 16, 1999, this Court issued an order denying Plaintiff's motion for partial summary judgment on literal infringement, denying Defendant's motion for partial summary judgment of noninfringement as to Trackball, and granting Defendant's motion summary judgment as to literal infringement.

STANDARD OF LAW

Summary judgment may be granted when the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law. FED. R. CIV. P.56(C). If the moving party meets its initial burden of identifying for the court those portions of the materials on file that it believes demonstrates the absence of any genuine issues of material fact, the burden of production then shifts so that the non-moving party must set forth, by affidavit or as otherwise provided in Rule 56, specific facts

showing that there is a genuine issue for trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 324 (1986); *T.W. Elec. Serv., Inc. v. Pacific Elec. Contractors Ass'n*, 809 F.2d 626, 630 (9th Cir. 1987). If the factual context makes the non-moving party's claim implausible, that party must come forward with more persuasive evidence than would otherwise be necessary to show that there is a genuine issue for trial. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986); *California Architectural Bldg. Prods., Inc. v. Franciscan Ceramics, Inc.*, 818 F.2d 1466, 1468 (9th Cir. 1987), *cert. denied*, 484 U.S. 1006 (1988). If the non-moving party bears the burden of proof with respect to an element essential to the case, and that party fails to make a sufficient showing to establish a genuine dispute of fact with respect to the existence of the element, summary judgment is appropriate. *Celotex*, 477 U.S. at 317; *California Architectural*, 818 F.2d at 1468.

DISCUSSION

I. Patent Infringement - 35 U.S.C. § 271(a)

Plaintiff contends that Defendant's "Trackman" and "Mouseman" products infringe Claim 7 of the '165 Patent in violation of section 271(a) of title 35 of the United States Code. Section 271(a) provides that, "whoever without authority makes, uses or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent." 35 U.S.C. § 271(a). Determining whether a patent claim has been infringed requires a two-step analysis in which the court first properly construes the claim, and then determines whether the accused method or product infringes the asserted claim as properly construed. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

In its August 16, 1999 Order, this Court construed Claim 7 of the '165 Patent to cover a hand controller with a support surface for the palm area of the user's hand, a support surface for the thumb and thumb pad, a support surface for the forefinger that allows the forefinger to be in a bent position, and an angular medial surface for supporting the three remaining ulnar fingers in a "wrapped," i.e. enclosed or folded, configuration. This Court then compared the construed claim to the Accused Products, and concluded there is no literal infringement on the grounds that the Accused Products do not contain the angular medial surface for supporting the three remaining ulnar fingers in a wrapped configuration. The remaining issue to be determined is whether the Accused Products infringe Claim 7 of the '165 Patent under the doctrine of equivalents.

A. Doctrine of Equivalents

A product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe where the elements of the accused device are "equivalent" to the corresponding elements of the patented invention. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997). An element is equivalent if the differences between the element and the claim limitation are "insubstantial." *Zelinski v. Brunswick Corp.*, 51 U.S.P.Q.2d 1590, 1594 (Fed. Cir. 1999). One test used to determine "insubstantiality" is whether the element performs substantially the same function in substantially the same way to obtain substantially the same result as the claim limitation. *Id.* Whether a claim is infringed under the doctrine of equivalents may be decided on summary judgment if no reasonable jury could determine that the limitation and the element at issue are equivalent. *Warner-Jenkinson*, 520 U.S. at 39 n.8.

Although infringement under the doctrine of equivalents is generally a question of fact, courts have developed an array of legal limitations, formulations and tests regarding the application of the doctrine of equivalents. *See K-2 Corp. v. Salomon S.A.*, 52 U.S.P.Q.2d 1001 (Fed. Cir. 1999). First, the doctrine of equivalents is limited in that it cannot allow a patent to encompass subject matter that could not have been patented, nor can it be used to ignore the actual language of the patent. *Id.* Second, the patentee may not use the doctrine of equivalents to recover subject matter that has been surrendered during prosecution. *Id.* These limitations on the doctrine of equivalents are questions of law. *Id.* Defendant contends that the Accused Products do not infringe Claim 7 of the '165 Patent under the doctrine of equivalents as a matter of law because the Accused Products do not contain the "wrapping" element, which transitions into a concave undercut for supporting the three remaining ulnar fingers, and that prosecution history estoppel precludes Plaintiff from claiming subject matter relinquished during prosecution. Plaintiff contends that all that is required for infringement of Claim 7 is an angular medial surface, not a ledge with a curved undercut or concave depression area beneath the ledge.

The '165 Patent states that immediately beneath the medial ledge is a concave ulnar finger support surface which is designed to support the middle, ring and small fingers, as depicted in surface area 24 in Figures 1, 2, 3, 5 and 8. ('165 Patent, col. 5:29-34). Both the '165 Patent, and the Prosecution History, state that one of the disadvantages of the prior art is that "there is no surface designed to receive the remaining three fingers, typically, the middle finger, the ring finger and the little finger." ('165 Patent, col. 1:64-67). The '165 Patent specifically distinguishes the claimed invention from prior art by stating that, for example, Patent No. 3,854,131 to Venderheiden does not include the

undercut curved areas for the middle, ring and small fingers, ('165 Patent, col. 2:28-37), Patent No. 4,550,250 to Mueller does not have an undercut curved area for the middle, ring and small fingers, ('165 Patent, col. 2:38-46), Patent No. 3,517,678 to Gilsdorf does not provide an undercut area for the user's middle, ring and small fingers. ('165 Patent, col. 2:57-63).

The "165 Patent also states that the precise shapes shown and described in the '165 Patent may be readily altered; for example, the concave depression beneath the medial ledge may be made flat without substantially reducing the principal advantages of the invention, and all such modifications and additions are deemed to be within the scope of the invention, which is limited only by the claims. ('165 Patent, col. 7:20-31). However, Claim 7 limits the claimed invention to having an angular medial surface for supporting the three remaining ulnar fingers in a "wrapped configuration." Based on evidence provided by Plaintiff, this Court construed the term "wrapped" within the phrase "wrapped configuration" to mean enfolded or enclosed in this Court's August 16, 1999 Order. Such a limitation is consistent with the descriptions of surface area 24 in the diagrams, and distinctions of the claimed invention to prior art in the "165 Patent. Thus, even if this Court were persuaded by Plaintiff's contention that infringement of Claim 7 does not require a surface area called a "curved undercut" or "concave depression" beneath the angular medial surface, this Court finds that the application of the doctrine of equivalents to the Accused Devices is limited by the plain language of Claim 7, which expressly requires that the angular medial surface support the middle, ring and small fingers in an enclosed or folded configuration.

Plaintiff provides this Court with exhibits of the Accused Products. (Plaintiff's Exhibits 47 - 51). In

comparing the Accused Products to the construed Claim 7, this Court finds that the Accused Products do not have an equivalent angular medial surface area shaped for supporting the three remaining ulnar fingers in a wrapped configuration; thus, Defendant is entitled to summary judgment under the doctrine of equivalents.

CONCLUSION

Based on the foregoing findings of fact and conclusions of law, this Court GRANTS Defendant's motion for summary judgment on non-infringement of Patent No. 4,862,165 as to the Accused Products under the doctrine of equivalents.

IT IS SO ORDERED

DATED: October __, 1999

CONSUELO B. MARSHALL
United States District Judge

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

SAMUEL GART,
Plaintiff-Appellant,

v.

LOGITECH, INC.,
Defendant-Appellee.

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the APPELLEE, and a response thereto having been invited by the court and filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc and response having been referred to the circuit judges who are in regular active service.

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED

The mandate of the court will issue on August 28, 2001.

FOR THE COURT

Jan Horbaly
Clerk

Serial No. 155, 197
Art Unit 264

Examiner's Amendment

1. An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the Issue Fee.

Authorization for this Examiner's Amendment was given in a telephone interview with Attorney Leonard Tachner on 3/21/89.

In line 4 of claim 1 after "comprising", --the following elements-- has been inserted. In line 3 of claim 5, after "housing", --with respect to the underlying surface-- has been inserted. In line 14 of claim 7, "remaining" (first occurrence) has been deleted.

2. The above amendments were required in order to comply with 35 U.S.C. 112, second paragraph.

3. The following is an Examiner's Statement of Reasons for Allowance: Independent claims 1 and 7 recite a hand controller computer input type apparatus, having various surfaces and shapes in order to provide support to various parts of a user's hand operating the device to minimize hand fatigue. The prior art fails to teach the details on the shape and surface of the hand controller taught by the instant claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the Issue Fee and, to avoid processing delays, should preferably accompany the Issue Fee. Such submissions should be

clearly labeled "Comments on Statement of Reasons for Allowance".

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tyrone Queen whose Telephone number is (703) 557-3354.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 557-3321

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

KX INDUSTRIES, L.P. and
KOSLOW TECHNOLOGIES CORPORATION,
Plaintiffs-Appellants,

v.

PUR WATER PURIFICATION PRODUCTS, INC.,
Defendant-Appellee.

00-1543

2001 U.S. App. LEXIS 18155

August 10, 2001, Decided

JUDGES: Before RADER, GAJARSA, and LINN, Circuit Judges.

OPINION:

LINN, Circuit Judge.

KX Industries, L.P. and Koslow Technologies Corp. (collectively "KXI") appeal from the decision of the United States District Court for the District of Delaware, which granted summary judgment in favor of PUR Water Purification, Products, Inc. ("PUR"), holding that PUR does not infringe claim 94 of U.S. Patent No. 5,019,311 ("the *'311* patent"). *KX Indus., L.P. v PUR Water Purif. Prods., Inc.*, No. 99-275 (D. Del. Aug. 9, 2000). The district court properly held that no reasonable jury could find that PUR infringed these claims either literally or under the doctrine of

equivalents. Thus, the district court's grant of summary judgment of no infringement is affirmed.

BACKGROUND

The technology of the '311 patent relates to preparation of composite materials used in water filtration, e.g., carbon block filters. These composite materials can be manufactured using a variety of techniques, such as extrusion, compression molding, and roll compaction.

The only independent claim that is at issue in the '311 patent is claim 94.[1] That claim sets forth a four-step

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[1] 94. A method of forming a composite material which comprises:

providing a quantity of first particles of a binder material, said first particles having diameters between about 0.1 and about 150 micrometers;

providing a quantity of second particles of a primary material having a softening temperature substantially greater than the softening temperature of said binder material, said second particles having diameters between about 0.1 and about 3,000 micrometers;

combining the first and second quantities of particles in a substantially uniform mixture wherein said binder material is present in an amount of at least about 3% by weight of the mixture;

heating said substantially uniform mixture, in the absence of pressure or shear sufficient to convert the binder particles, to a temperature substantially above the softening temperature of said binder material but to a temperature less than the softening temperature of said primary material;

thereafter applying pressure and shear to the heated mixture sufficient to substantially immediately convert at least a portion of

process for producing either a continuous web matrix ("cwm") composite material of binder particles and primary particles or a forced point bond ("fpb") composite material of binder particles and primary particles. The particular limitations of claim 94 in dispute are "heating said substantially uniform mixture, in the absence of pressure or shear sufficient to convert the binder particles . . . ," and "thereafter applying pressure and shear to the heated mixture to substantially immediately convert at least a portion of the binder material particles into a substantially continuous webbing structure or to cause forced point-bonding of the particles of the primary material by the binder material . . . ."

PUR manufactures carbon blocks using a compression molding technique. PUR's process involves combining carbon particles with microfine polyolefin powder particles, heating the mixture in a pressurized cylinder wherein the pressure remains constant through the heating process and is at a level from 95 psi to 140 psi.

PUR moved for summary judgment of noninfringement contending, among other things, that the claimed process requires, for a compression molding process, heating in the absence of pressure or shear. In addition, PUR contended that for all techniques of manufacturing the composite material encompassed by the

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the binder material particles into a substantially continuous webbing structure or cause forced point-bonding of the particles of the primary material by the binder material; and

substantially immediately after formation of said binder particles into a webbing structure or forced point-bonds, rapidly cooling said mixture to below the melting point of the binder material to retain said converted binder material in its continuous webbing structure or forced point-bonded condition to produce the composite material.

claim, the applied pressure must be greater than 400 psi after the heating step. PUR notes that it does not perform either of these steps in its compression molding process and thus argues that it cannot be found to infringe claim 94.

KXI filed a cross-motion for summary judgment of infringement contending among other things that the heating step of the claimed process does not need to be performed in the absence of pressure or sheer. According to KXI, the process only requires the absence of sufficient pressure and shear to convert the binder material until after the mixture has been heated above the softening temperature of the binder. In addition, KXI contended that to the extent that the pressure step is limited numerically, it is only limited to pressures above 40 psi not 400 psi. Based on the foregoing interpretation, KXI asserts that PUR's process must be found to infringe claim 94.

In its decision concluding that PUR does not infringe claim 94, the district court applied the doctrine of disclaimer to determine that for a compression molding process, the heating limitation is limited to "no pressure being applied." That disclaimer was discerned from the following portion of the specification under the heading "B. Compression Molding:"

> During heating, no pressure is applied and no effort is made to consolidate the powder. The powder must be at the desired temperature before pressure and shear are applied.

'311 patent, col. 18, l. 67-col. 19, l. 2.

In addition, as for the applying pressure limitation, the district court again applied the doctrine of disclaimer to determine that the pressure applied must be greater than 400

psi. That disclaimer was discerned from statements in the specification under the heading "II. Background Art" that distinguish the invention from United States Patent No. *4,664,683* (the "Degen patent") and from statements in the Degen patent itself. These statements are as follows:

> The levels of compression disclosed by Degen et al. are exceedingly low, 0.3-10 psi (0.21-0.703 kg/cm2) most preferred maximum 40 psi (2.91 kg/cm2). Accordingly, it describes process conditions well outside the range of compression utilized in the present invention, which would be 400-1000 psi (28.1-70.31 kg/cm2) for granular materials (i.e. 10-50 mesh) and approximately 8,000 psi (562.48 kg/cm2) or more for powders (typically, 100-600 mesh). Without such higher pressures, the binder resins are not activated and the novel structures produced by the current invention are not obtained.

'*311* patent, col. 2, II. 40-51.

> Pressures in the range of up to the crush strength of the carbon, which is about 400 psi, are suitable although, from a practical perspective, pressures up to about 40 psi are preferred and from about 0.3 to about 10 psi are most preferred.

The Degen patent, col. 10, II. 10-14.

Based on its construction, and the undisputed fact that in PUR's process, PUR applies pressure below 400 psi and applies some pressure and shear during heating, the

district court determined that no reasonable jury could conclude that PUR's process literally infringes claim 94. Moreover, the district court determined that these disclaimers precluded KXI from asserting that PUR's process infringes under the doctrine of equivalents.

KXI timely appealed from the final judgment entered by the district court in favor of PUR. We have jurisdiction under 28 U.S.C. § 1295(a)(1) (1994).

DISCUSSION

I. Standard of Review

We review a district court's grant of summary judgment de novo. *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 149 F.3d 1309, 1315, 47 USPQ2d 1272, 1275 (Fed. Cir. 1998). However, in reviewing a denial of a motion for summary judgment, we give deference to the trial court, and "will not disturb the trial court's denial of summary judgment unless we find that the court has indeed abused its discretion." *Suntiger, Inc. v. Scientific Research Funding Group*, 189 F.3d 1327, 1333, 51 USPQ2d 1811, 1815 (Fed. Cir. 1999). When both parties move for summary judgment, the court must evaluate each motion on its own merits, resolving all reasonable inferences against the party whose motion is under consideration. *McKay v. United States*, 199 F.3d 1376, 1380 (Fed. Cir. 1999).

Summary judgment is appropriate only when there are no genuine issues of material fact and the moving party is entitled to judgment as a matter of law. FED. R. CIV. P. 56(c). "In determining whether there is a genuine issue of material fact, the evidence must be viewed in the light most favorable to the party opposing the motion, with doubts resolved in favor of the opponent." *Chiuminatta Concrete*

Concepts, Inc. v. Cardinal Indus., Inc., 145 F.3d 1303, 1307, 46 USPQ2d 1752, 1755 (Fed. Cir. 1998). If there are no material facts in dispute precluding summary judgment, "our task is to determine whether the judgment granted is correct as a matter of law." *Prochorenko v. United States*, 243 F.3d 1359, 1362 (Fed. Cir. 2001).

A determination of infringement requires a two-step analysis. "First, the claim must be properly construed to determine its scope and meaning. Second, the claim as properly construed must be compared to the accused device or process." *Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1576, 27 USPQ2d 1836, 1839 (Fed. Cir. 1993). "In order for a court to find infringement, the plaintiff must show the presence of every element or its substantial equivalent in the accused device." *Wolverine World Wide, Inc. v. Nike, Inc.*, 38 F.3d 1192, 1199, 32 USPQ2d 1338, 1341 (Fed. Cir. 1994). Claim construction is an issue of law, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71, 34 USPQ2d 1321, 1322 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (1996), that we review de novo. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456, 46 USPQ2d 1169, 1172 (Fed. Cir. 1998) (*en banc*). The determination of infringement, whether literal or under the doctrine of equivalents, is a question of fact. *Bai v. L & L Wings, Inc.*, 160 F.3d 1350, 1353, 48 USPQ2d 1674, 1676 (Fed. Cir. 1998).

II. Analysis

A. Claim Construction

"All express representations made by or on behalf of the applicant to the examiner to induce a patent grant," limit the interpretation of the claims "so as to exclude any

interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance." *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452, 227 USPQ 293, 296 (Fed. Cir. 1985); *Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d 951, 955, 55 USPQ2d 1487, 1490 (Fed. Cir. 2000) ("Review of the prosecution history . . . reveals that the inventor disclaimed a particular interpretation of groove, thereby modifying the term's ordinary meaning."); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1676 (Fed. Cir. 1995) ("The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution."). Furthermore, where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question. *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341, 58 USPQ2d 1059, (Fed. Cir. 2001); *Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328, 1331, 56 USPQ2d 1208, 1210 (Fed. Cir. 2000) ("Claims are not correctly construed to cover what was expressly disclaimed."). But any limitation of the meaning attributed to the claim language based on such disclaimer must be shown in the intrinsic record with reasonable clarity and deliberateness. *Northern Telecom Ltd. v. Samsung Electronics Co.*, 215 F.3d 1281, 55 USPQ2d 1065, 1075 (Fed. Cir. 2000).

In view of the foregoing, express statements or arguments of limitation made in an information disclosure statement ("IDS"), in discussions with the examiner, or in the specification of the patent itself are all relevant in determining whether the express terms of the claim must be

limited to exclude disclaimed subject matter. So, just as an argument contained in an IDS that purports to distinguish an invention from the prior art may affect the scope of the claims of a granted patent, *Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1304, 41 USPQ2d 1364, 1368 (Fed. Cir. 1997), so may a clear statement distinguishing the invention from the prior art that is in the specification itself. *See Pall Corp. v. PTI Techs., Inc.*, Nos. 00-1203 and -1215, slip op. at 14-15 (Fed. Cir. Aug. 3, 2001).

In this case, the inventor distinguished his invention from Degen as a kind of preemptive strike against a potential rejection. It is not clear that the assertions made were necessary for allowance of the claims. However, whether the limiting assertions made were necessary for allowance of the claims is not dispositive as to whether a patentee has disclaimed certain subject matter. *Cf. Texas Instruments Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1174, 26 USPQ2d 1018, 1025 (Fed. Cir. 1993) (noting in the context of prosecution history estoppel that unmistakable assertions made during prosecution in support of patentability, whether or not actually required to secure allowance of the claim, may operate to preclude the patentee from asserting equivalency). Rather, what is determinative is whether the patentee has defined a claim term as excluding a broader interpretation with reasonable clarity and deliberateness. *See Pall*, slip op. at 15.

We conclude that the inventor made an unambiguous assertion as to the minimum compression level needed to activate the binders in the claimed invention so as to obtain the novel cwm and fpb composite materials. In other words, the inventor, with reasonable clarity and deliberateness, articulated that "400-1000 psi (28.1-70.31 kg/cm2) for granular materials (i.e. 10-50 mesh) and approximately 8,000 psi (562.48 kg/cm2) or more for powders (typically, 100-600

mesh)" is the necessary range of compression for obtaining the claimed composite materials. '311 patent, col. 2, II. 45-47. Thus, despite the fact that this range is not set forth in the claim itself, the intrinsic record evinces with reasonable clarity and deliberateness that the inventor clearly disavowed the particular feature of pressures not within "400-1000 psi (28.1-70.31 kg/cm2) for granular materials (i.e. 10-50 mesh) and approximately 8,000 psi (562.48 kg/cm2) or more for powders (typically, 100-600 mesh)." *Id.*

Admittedly, there are two references in the specification to broad pressure ranges each using 50 psi as the lower limit. '311 patent, col. 6, II. 30-36 ("The major variation in process conditions is the use of either high (generally greater than 4000 psi . . .) or low (generally greater than 50 psi . . . but less than 4000 psi.")); *id.* at col. 12, II. 41-43 ("the basic requirements [of the process] include . . . [placing] the mixture . . . under sufficient applied pressure, generally at least about 50 psi . . . ."). However, these two general references are insufficient to convince us that the inventor did not clearly disavow operating pressures for the invention of less than 400 psi. That is because the inventor stated unambiguously and without qualification that a minimum of 400 psi is necessary to activate the binder resins, and such activation is a necessary step in obtaining the novel cwm and fpb composite materials with the claimed process. *Id.* at col. 2, II. 48-51 ("without such higher pressures [i.e., 400 psi -1000 psi for granular materials and 8,000 psi or more for powder materials] the binder resins are not activated and the novel structures produced by the current invention are not obtained." (emphasis added)). The fact that the inventor chose to express the minimum pressure level needed for activation in the Background section makes it no less important in determining what the inventor deemed necessary to the claimed process to achieve his novel cwm and fpb composite materials.

Moreover, the first reference to 50 psi in the written description is made in the context of generally pointing out the process conditions that generically distinguish the ability to obtain a cwm composite material from the ability to obtain an fpb composite material. Id. at col. 6, II. 30-36 ("The variations in the process conditions described here result in two alternative structures that are distinctly different internally . . . the major variation . . . [being] the use of either high (generally greater than 4000 psi . . .) or low (generally greater than 50 psi . . . but less than 4000 psi.) pressure to accomplish the process . . . ."). The second reference to 50 psi is immediately followed by the added condition that "the applied pressure must be sufficient to 'activate' the binder . . . ." Id. col. 12, II. 50-52. Thus, the two general statements in the written description regarding the use of pressures within broad ranges starting from above 50 psi do not make the inventor's clear and deliberate disavowal unambiguous. Rather, these statements, in view of the clear statement by the inventor of what he deems necessary for activation of the binder resins and, thus, the operability of the claimed process to achieve his novel cwm and fpb composite materials structures, can only be deemed to be incorrect.

We need not address the district court's construction of the heating limitation because, as will be discussed below, comparison of the PUR process to claim 94 in view of the interpretation of the pressure step is dispositive of the infringement issues on appeal.

B. Infringement

After claim construction, the next step in an infringement analysis is comparing the properly construed claims with the allegedly infringing devices. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1360, 54

USPQ2d 1308, 1312 (Fed. Cir. 2000). This comparison is a question of fact. *Id.* Thus, if we agree with the district court that there are no genuine issues of material fact, and the movant is entitled to judgment as a matter of law, we can affirm the district court's grant of summary judgment. FED. R. CIV. P. 56(c); *Celotex*, 477 U.S. at 322; *see Vehicular Techs. Corp. v. Titan Wheel Int'l, Inc.*, 212 F.3d 1377, 1381, 54 USPQ2d 1841, 1843 (Fed. Cir. 2000) (holding that a fact issue is not in genuine dispute if a reasonable jury could only find in favor of the moving party).

Literal infringement of a claim occurs when every limitation recited in the claim appears in the accused device, i.e., when "the properly construed claim reads on the accused device exactly." *Amhil Enters., Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1562, 38 USPQ2d 1471, 1476 (Fed. Cir. 1996). Infringement under the doctrine of equivalents requires that the accused product contain each limitation of the claim or its equivalent. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40, 137 L. Ed. 2d 146, 117 S. Ct. 1040 (1997) (noting that because each limitation contained in a patent claim is material to defining the scope of the patented invention, a doctrine of equivalents analysis must be applied to individual claim limitations, not to the invention as a whole). An element in the accused product is equivalent to a claim limitation if the differences between the two are "insubstantial" to one of ordinary skill in the art. *See id.*

It is undisputed that the PUR process employs pressures well below 400 psi as required by claim 94, i.e., ninety-five psi to 140 psi. Thus, the PUR process does not literally infringe claim 94.

Moreover, as explained above, the *'311* patent makes it clear that without pressures of 400 psi or more the binder resins are not activated and the novel structures are not

obtained. Consequently, the much lower pressures employed by PUR cannot, as a matter of law, be insubstantially different from 400 psi. Therefore, the PUR process using such pressures cannot infringe claim 94 under the doctrine of equivalents.

For the foregoing reasons, we affirm the district court's conclusion on summary judgment that PUR's process does not infringe claim 94, literally or under the doctrine of equivalents.